Supreme Court, U. S.
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IN THE

Supreme Court of the United States

No. 77-203

EDWARD S. IRONS,

Petitioner,

v.

COMMISSIONER OF PATENTS,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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TABLE OF CONTENTS

	Page
The Opinion Below	1
Jurisdiction	2
Questions Presented	2
Constitutional Provisions and Statutes Involved	3
Statement of the Case	6
Reasons why the Writ should be Granted	14
Conclusion	19
Appendix A	
Decision, October 21, 1976, Appeal from the United States District Court for the District of Columbia	1a
Appendix B	
Memorandum-Order of the District Court, entered January 10, 1974	12a
Appendix C	
Memorandum-Order of the District Court, Entered March 11, 1974	25a
Appendix D	
March 8, 1977 Order of the Court of Appeals	30a
Appendix E	
Motion of Appellant under Appellate Rule 27 for Correction of Factual Errors in Opinion Filed October 21, 1976	31a
Appendix F	
Order of the Court of Appeals	34a
Appendix G	
5 U.S.C. 552	35a

TABLE OF AUTHORITIES

CASES

	Page
Blonder-Tongue Lab., Inc. v. *University of Ill. Foundation*, 402 U.S. 313 (1971)	15
Clay v. *Waters*, 178 F. 387 (8 Cir. 1910)	17
Deepsouth Packing Co. v. *Laitram Corp.*, 406 U.S. 518 (1972)	15
Graham v. *John Deere Co.*, 383 U.S. 1 (1966)	14, 16
Great A & P Tea Co. v. *Supermarket Equipment Co.*, 340 U.S. 147 (1950)	16
Irons v. *Schuyler*, 321 F.Supp. 628 (D.D.C. 1970)	6
Irons v. *Schuyler*, 465 F.2d 608 (D.C.C. 1972)	6
Kendall v. *Winsor*, 62 U.S. 322 (1858)	15
Kewanee Oil Co. v. *Bicron Co.*, 416 U.S. 470 (1974)	14, 15
Lear, Inc. v. *Adkins*, 395 U.S. 653 (1969)	15
Mercoid Corp. v. *Mid-Continent Inv. Co.*, 320 U.S. 661 (1944)	15
Merrimack River Savings Bank v. *City of Clay Center*, 219 U.S. 527 (1911)	17
Motion Picture Patents Co. v. *Universal Film Manufacturing Co.*, 243 U.S. 502 (1917)	15
National Labor Relations Board v. *Sears, Roebuck & Co.*, 421 U.S. 132 (1975)	14, 15
Pennock v. *Dialogue*, 27 U.S. 1 (1829)	15
Sears, Roebuck & Co. v. *National Labor Relations Board*, 346 F.Supp. 751 (D.D.C. 1972), aff'd F.2d 1195 (D.C.C. 1973)	17
Shaw v. *Cooper*, 32 U.S. 292 (1833)	15
Tax Analysts and Advocates v. *Internal Revenue Service*, 365 F.Supp. 1298 (D.D.C. 1973)	18
The Duplan Corporation v. *Deering Milliken et al*, No. 71-306 (D.S.C.)	14
United States v. *Columbia Broadcasting System*, 497 F.2d 107 (5 Cir. 1974)	18
United States v. *Masonite Corp.*, 316 U.S. 265 (1942)	15

TABLE OF AUTHORITIES—Continued

	Page
UNITED STATES CONSTITUTION	
Fifth Amendment	5
STATUTES	
Stat. 117 (1836)	16
5 U.S.C. § 552	3, 6, 12, 17
5 U.S.C. § 552(a)	15, 17
5 U.S.C. § 552(a)(2)	2, 3, 6, 7, 10, 12, 13, 14, 17
5 U.S.C. § 552(a)(2)(A)	2, 3, 10, 12
5 U.S.C. § 552(a)(2)(B)	2, 3, 10, 12, 18
5 U.S.C. § 552(a)(2)(C)	2, 3, 10, 12, 18
5 U.S.C. § 552(a)(3)	6, 9
5 U.S.C. § 552(c)	9
5 U.S.C. § 553(a)(3)	9
28 U.S.C. § 455(a)	18
28 U.S.C. § 1254(1)	2
35 U.S.C. § 122	2, 3, 5, 10
RULES	
Federal Civil Rule 1	11
MISCELLANEOUS	
S.R. 93-419, 93 Cong., 1st Sess. (1973)	18
H.R. 93-1453, 93 Cong., 2d Sess. (1974)	18
H.R. No. 1497	15
Hearings before the Subcommittee on the Judiciary, U.S. Senate, 93 Cong., 1st Sess.	18
121 Cong. Rec. 19433	15
Davis, The Information Act: A Preliminary Analysis, 34 U.Chi.L.Rev. 761 (1967)	14
Disqualification of Judges and Justices in the Federal Courts, 86 Harvard L. Rev. 736 (1973)	18

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Petitioner prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the District of Columbia Circuit entered in this proceeding on October 21, 1976, as modified *sua sponte* by the Court on March 8, 1977.

THE OPINION BELOW

The opinion of the Court of Appeals is reproduced as Appendix A, *infra*, p. 1a. The opinion of the district court is unreported and is set forth in orders dated January 10, 1974 and March 11, 1974 which are reproduced respectively as Appendices B and C, *infra*, pp. 12a and 25a, respectively.

JURISDICTION

The opinion of the Court of Appeals for the District of Columbia Circuit was filed on October 21, 1976.[1] Timely petitions of both parties for rehearing were denied on March 8, 1977 and the Court concurrently modified its opinion *sua sponte* by the order reproduced as Appendix D, *infra*, p. 30a. This petition for writ of certiorari is filed within the 60-day enlarged period afforded by two requests for extension of time duly granted by the Chief Justice, the second of which expires August 5, 1977. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Is public accessibility of at least the following "information" relating to applications for patents "necessary to carry out the provisions of" 5 U.S.C. 552(a)(2), and, hence, expressly exempted from the "confidence" provision of 35 U.S.C. 122: (i) decisions of Patent Office tribunals within the ambit of subsections A, B and C of 5 U.S.C. 552(a)(2), and, (ii) any records, such as docket cards, which are capable of serving as aids to locating the decisions referred to in (i)?

2. Was the Patent Office required to retain all docket cards and other records capable of serving as aids in locating decisions defined in 5 U.S.C. 552(a)(2)(A), (B) and (C) throughout the pendency of a civil action specifically seeking access, *inter alia*, to all indices to its decisions?

(a) was the deliberate surreptitious postcomplaint destruction of such records by the Patent

[1] Petitioner also filed a timely motion to correct factual errors in the opinion reproduced as Appendix E, *infra*, p. 31a, which was denied by an order dated January 19, 1977, reproduced as Appendix F, p. 34a, *infra*.

Office and the disingenuous representation enabled thereby—*to wit*, that the decisions could not be located without an unduly burdensome search of every agency file—deliberately contemptuous of the processes of the law and the substantive mandate of 5 U.S.C. 552(a)(2)?

3. Under 5 U.S.C. 552, must the Patent Office index not only "final decisions" of its tribunals as defined in 5 U.S.C. 552(a)(2)(A) but also decisions, whether or not "final", which constitute agency construction, by tribunals empowered to speak for the agency, of rules of the Patent Office and sections of the Patent Act, and, hence, fall within the definitions set forth in 5 U.S.C. 552(a)(2)(B) and (C)?

4. Was the district judge disqualified from participating in this case by his *sua sponte* dispatch, without notice or opportunity for objection, of his law clerk to two Patent Office locations for clandestine *ex parte* consultations, the substance of which has never been revealed but was used as the premise for fact findings that the record does not otherwise support?

5. Did the Court of Appeals have prerogative to refuse to correct factual errors in its opinion?

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

This case directly involves the Freedom of Information Act, 5 U.S.C. 552, especially Section (a)(2) thereof, and 35 U.S.C. 122, as well as the due process clause of the Fifth Amendment to the Constitution. The current version of 5 U.S.C. 552 in its entirety is reproduced as Appendix G *infra*, p. 35a.

5 U.S.C. 552(a)(2) reads:

"(a) Each agency shall make available to the public information as follows:

* * * *

"(2) Each agency, in accordance with published rules, shall make available for public inspection and copying—

(A) final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases;

(B) those statements of policy and interpretations which have been adopted by the agency and are not published in the Federal Register; and

(C) administrative staff manuals and instructions to staff that affect a member of the public;

unless the materials are promptly published and copies offered for sale. To the extent required to prevent a clearly unwarranted invasion of personal privacy, an agency may delete identifying details when it makes available or publishes an opinion, statement of policy, interpretation, or staff manual or instruction. However, in each case the justification for the deletion shall be explained fully in writing. Each agency shall also maintain and make available for public inspection and copying current indexes providing identifying information for the public as to any matter issued, adopted, or promulgated after July 4, 1967, and required by this paragraph to be made available or published. Each agency shall promptly publish, quarterly or more frequently, and distribute (by sale or otherwise) copies of each index or supplements thereto unless it determines by order published in the Federal Register that the publication would be unnecessary and impracticable, in which case the agency shall nonetheless provide copies of such index on request at a cost not to exceed the direct cost of duplication. A final order, opinion, statement of policy, interpretation, or staff manual or instruction that affects a member of the public may be relied on, used, or cited as precedent by an agency against a party other than an agency only if—

(i) it has been indexed and either made available or published as provided by this paragraph; or

(ii) the party has actual and timely notice of the terms thereof.

(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, upon any request for records which (A) reasonably describes such records and (B) is made in accordance with published rules stating the time, place, fees (if any), and procedures to be followed, shall make the records promptly available to any person."

35 U.S.C. 122 reads:

"Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." [2]

The due process clause of the Fifth Amendment reads:

"No person shall be . . . deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation."

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[2] The quoted version of the statute reflects its 1975 amendment to substitute "Patent and Trademark office" for "Patent Office". As originally promulgated in 1952, the statute is substantially identical and reads:

"Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. July 19, 1952, c.950, § 1, 66 Stat. 801."

STATEMENT OF THE CASE

Petitioner, an experienced patent lawyer, filed suit on January 12, 1970, to compel disclosure of "all unpublished decisions of the Patent Office" and existing indices thereto pursuant to Section (a)(2) of the Freedom of Information Act, 5 U.S.C. 552. On October 26, 1970, the district court refused to order that the decisions be made publicly available on grounds that the complaint and underlying request did not define "identifiable records" within the meaning of 5 U.S.C. 552(a)(3), but directed the Commissioner of Patents to commence compiling indices of decisions rendered since the effective date of the act, July 4, 1967, "insofar as . . . required by 5 U.S.C. 552(a)(2)", *Irons* v. *Schuyler*, 321 F.Supp. 628, 629 (D.D.C. 1970). The order that the Commissioner should index post-July 4, 1967 decisions was not appealed;[3] the refusal of access to the decisions *per se* was.

The Court of Appeals for the District of Columbia Circuit affirmed the holding that the request was not for "identifiable records" but remanded for a determination of the complaint's claim for access to those indices of pre-July 4, 1967 Patent Office decisions that existed at the date of the complaint, *Irons* v. *Schuyler*, 465 F.2d 608 (D.C. Cir. 1972).

Rehearing was sought by petitioner, *inter alia*, on the ground that the appellate court's holding as to the "unidentifiable" nature of the decisions was premised upon the false affidavit of an agency employee.[4] The Court of

[3] The decision below inaccurately states that the order to index was "affirmed by this court [of appeals]" (3a). The error was timely called to the Court's attention in the motion for correction, *infra*, 31a, and correction was refused by the order dated January 19, 1977 reproduced at 34a, *infra*.

[4] This affidavit was at that time shown to be materially false in its paragraph 9 which represents that 3,500,000 files exist and implies all would have to be searched. Actually, the record shows the affiant himself later estimated that 600,000 or less of such files have actually been preserved and hence are even capable of being so searched. Moreover, the affiant deliberately implied that there was *no way* of locating the decisions scattered in these files except physical search thereof.

The affidavit was nevertheless allowed by the Patent Office to stand unretracted throughout the remanded proceeding.

In fact, as confessed during the subsequent proceedings on remand, the docket cards which *did* exist in their entirety when the litigation was filed, contained a complete summary of the content of *all* files. See text, *infra*, p. 8. These cards *could* hence have been searched far more easily than the files *per se* and *would* have located all of the decisions in issue within a reasonable time.

Nevertheless, the accused affidavit concealed all facts showing that these cards *had* existed and had in part been destroyed by the agency after this litigation commenced, in an effort—which has so far been shockingly successful—to gain an unfair advantage in this case and continue the suppression of Patent Office decisions.

Appeals thereupon modified its decision to recognize expressly that opinions of Patent Office tribunals which fall within the literal ambit of 5 U.S.C. 552(a)(2) "are of course identifiable"[5] (*id.* at 614) and accordingly rested its decision upon the euphemism that the original complaint was "broader than the statutory limits of Section 552(a)(2)" (*ibid.*). Emphasis continued to be placed upon the "large and indefinite number of records [involved] which have accumulated over the entire history of this agency" (*id.* at 614-615). The rehearing decision suggested that the complaint might be amended on remand to permit the matter to be appropriately resolved (*id.* at 615).

Since the availability of indices was the paramount reason given for ordering a remand and was also significant to the petitioner's ability to further define the

[5] Said the Court of Appeals further,

> "The District Court did not hold, nor do we, that the manuscript decisions of the Patent Office are exempt, as such, from disclosure. . ." 465 F.2d at 614.

requested records, attention was focussed upon this question in the remanded proceeding. Petitioner sought access, as he had continuously done since initiating the litigation, to certain Patent Office records known as "docket cards" which summarize the contents of each patent application, patent interference file or patent appeal.[6]

It thereupon developed that the Patent Office had destroyed, *post-complaint*, the great bulk of these pre-July 4, 1967 "docket cards". The excuse was a one-time change in its docketing and record keeping system, from use of the cards to use of a computer controlled memory device, which admittedly took place *after* the complaint was filed.

The district court brushed aside this Patent Office destruction of the docket cards as "routine" (24a) notwithstanding the agency's *own* statement of record showing this destruction to be a *non*-routine, one-time effort. The district judge held that "This sort of material is not a true index", apparently because he found the cards not "collected in any way that would serve a regular index function within the Patent Office, and they contain considerably more information about individual applications than do the indices" (App. B, 17a) he released. The latter appear in the front of each of 144 bound volumes of decisions for the period 1853 to 1923 and their content is only the bare "name of the applicant" (14a) whereby they will necessarily be of very limited use.

The refusal to order release of the undestroyed docket cards or to impose sanctions for the destruction of the

[6] The district judge acknowledged expressly that the docket card "is a master card recording each and every event in the course of processing a patent application" (17a) and hence, implicitly recognized that examining all of the docket cards would afford a means of easily identifying all of the decisions sought within a reasonable time.

remainder is incongruous in face of the district court's acknowledgment that

> "*Without the aid of some sort of index, plaintiff will forever be unable to formulate with specificity a request for . . . decisions that would permit the Patent Office to produce the material desired. . . .*" (14a; emphasis added)

and its further concession that

> "It is possible to order the reproduction of existing indices insofar as they are 'identifiable records' . . . under 5 U.S.C. § 552(a)(3)." (14a).

There was *no* finding that the docket cards were *not* "identifiable records" under 5 U.S.C. 552(a)(3). The record amply shows they so qualified. The district court's refusal to so treat them because of its conclusion they are not "a true index" cannot be rationalized with 5 U.S.C. 553(a)(3) and 5 U.S.C. 552(c).

These inconsistent district court rulings concerning the docket cards and the bound volume indices were made *only after* the district court had clandestinely arranged for its law clerk to visit two Patent Office locations[7] without notifying the plaintiff or its counsel until *after* the visits were a *fait accompli*. Just *who* the law clerk met with in either place or precisely *what* occurred has never been revealed.[8] Neither has the duration of the

[7] Namely, the Federal Records Center in Suitland, Maryland and the Patent Office *per se* in Arlington, Virginia.

[8] The district court has repeatedly referred to this exercise as only "inspection" (13a, n.7; 22a, 26a, 27a, 29a) at both locations but has also acknowledged an "effort . . . to more accurately ascertain what lay at the root of this action. . . ." (26a) *unrevealed* to plaintiff until "the memorandum Order of January 10, 1974" (*ibid.*), and has never denied that *ex parte* consultation occurred during the inspection. Nor has the district court offered *any* explanation of the basis for those of its fact findings that *prima facie* have *no* record support.

meetings, both of which are said to have occurred on November 30, 1973.

The district court also denied petitioner's motion for enforcement of the October 26, 1970 *unappealed* final order requiring the Patent Office to prepare and maintain current an index of July 4, 1967 decisions as defined by 5 U.S.C. 552(a)(2). This motion *could* have been made at any time, but was advanced during the proceedings on remand because petitioner first discovered just before and during those proceedings that the Patent Office had self-servingly construed 5 U.S.C. 552(a)(2) as exempting it from indexing or making publicly available any decisions other than so-called "final decisions" as defined in 5 U.S.C. 552(a)(2)(A). The district court's refusal to enforce its original order to require indexing of decisions within the scope of 5 U.S.C. 552(a)(2)(B) and (C) was rendered on the basis of its law clerk's *unrevealed ex parte* off the record consultation with defendants' unnamed representatives during the aforementioned visit. It is premised upon a finding, not supported by the record, "that there are apparently no statements of policy, staff manuals or staff instructions that are not already available to the public" (23a). This finding *could* have been demonstrated to be untrue *if* petitioner had been afforded an opportunity to cross-examine the persons who conveyed this misinformation to the law clerk or had been given an opportunity for refutation or rebuttal.

The district court also (i) refused to permit the filing of an amended complaint couched in the language of 5 U.S.C. 552(a)(2) so as to define decisions "of course identifiable" (465 F.2d at 614) under the earlier Court of Appeals rehearing decision and (ii) refused to order production of any of the decisions *per se*—including those collected in 175 bound volumes covering the 1853-1954 period—on the ground that 35 U.S.C. 122 precludes public availability of decisions on which no patent has issued.

A timely motion to recuse the judge, vacate the tainted order and reopen proceedings, because of the indulgence in and reliance on improper *ex parte* clandestine consultation with defendant in lieu of affording plaintiff a fair opportunity to know the evidence, to cross-examine and to rebut, was denied on March 11, 1974 (App. C, 25a to 29a). That order appears to confess the irregularity of the district court's procedures but purports to justify them as conducive to speed under Federal Civil Rule 1[9] and on the ground that the district judge, examining *in camera* the *unrevealed* particulars of his own conduct, self-servingly "finds no element of prejudice to the plaintiff in the action of November 30, 1973 [*i.e.*, the alleged "inspection" tour at two Patent Office locations]" (29a).

This "no prejudice" finding rests in part on a finding that the "Court's characterization of docket cards . . . as not being meaningful indices" (29a) was supported in an earlier unsworn memorandum of the Patent Office, *bona fides* of which petitioner had earlier attempted to explore by discovery, but been precluded by court order from pursuing. The designated memorandum, however, contains only the bare conclusion that "docket cards now in existence [*i.e.*, those still undestroyed] do not constitute an *index* or available *indices* to manuscript decisions. . . ." [Appendix in No. 74-1365, at 113]. The rationale given is that the cards are an index to the *totality* of patent application files and not just to indices. There *is nothing* in the memorandum about how cards are "collected" in the Patent Office; *cf.* 17a, *infra*, the district court fact finding that the same cards are not "collected in any way that would serve a regular index function within the Patent Office"—which *necessarily* came from the *ex parte* off-the-record consultation between defendant and the district court.

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[9] Conspicuously ignored here was that Rule 1 explicitly places "just" judicial action *at least* on a par with action that is "speedy".

The March 11, 1974 opinion of the district court tacitly concedes, by omitting any mention thereof even though the point *was* raised by petitioner, that its finding "that there are apparently no statements of policy, staff manuals or staff instructions that are not already available to the public" (23a, *infra*) and its assertions as to Patent Office "plans" in note 26 of the January 10, 1974 order (23a, *infra*) came from *off-the-record* information received *ex parte* and clandestinely.

The impropriety of this conduct, however, and its *per se* prejudicial effect on petitioner's case were sought to be camouflaged in the January 10, 1974 decision itself by the district court's *nunc pro tunc* amendment of its own October 26, 1970 order to limit applicability to decisions defined in 5 U.S.C. § 552(a)(2)(A). The October 26, 1970 order as published at 321 F.Supp. 628 is perforce applicable to *all* decisions defined by 5 U.S.C. 552(a)(2) because its language contains no qualification. The January 10, 1974 order, however, expediently alleges that failure to index decisions defined in 5 U.S.C. 552(a)(2)(B) and (C) is not properly before the district judge because the earlier order applies only to decisions covered by 5 U.S.C. 552(a)(2)(A).

In the ensuing proceedings before the Court of Appeals for the District of Columbia Circuit, that court refused to address itself to any issues raised except two: *i.e.*, whether the district court should have permitted the filing of the amended complaint and whether the 175 bound volumes of Patent Office decisions for the period 1853-1954 should have been made available under 5 U.S.C. 552. The result of the Court of Appeals deliberation, in that court's own words, was

> "In summary, our findings are as follows: (1) the appellant's amended complaint was specific enough to place the burden of claiming specific exemptions for specific parts of the manuscript decisions and the volumes on the agency; (2) 35 U.S.C. § 122 does not exempt either the requested manuscript decisions or the requested volumes in toto, but rather exempts only portions of the requested material containing detailed information and salient knowledge pertaining to the patent application; (3) determination as to which documents constitute 'final opinions' was impossible due to our lack of an adequate record." (App. A, 10a)

For these reasons, the Court of Appeals gave its

> "opinion that this case should be remanded to the district court for determining which materials are exempt and which are non-exempt, and with directions to the Patent Office to excise those portions of the requested documents which would reveal confidential information, and other proceedings not inconsistent with this opinion." (App. A, 10a-11a)

The Court of Appeals thereby failed—even refused—to address squarely any of the questions that are posed by this petition. It thereby insured that this already seven-year-old litigation will not end in the reasonably foreseeable future and encouraged continuing Patent Office recalcitrance and suppression of decisions covered by 5 U.S.C. 552(a)(2) at least for the near term.[10] Its failure to make any definitive disposition of the issues is compounded by the many fact errors in its opinion (App. E, 31a to 33a, *infra*)—and its summary refusal (App. F, 34a, *infra*) to correct them.

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[10] See in this regard the footnote added March 8, 1977 (App. D, *infra*, 30a) which invites the Patent Office to continue a cat-and-mouse game of thinking up reasons to justify continued withholding. While other portions of the decision do admonish the Patent Office to be less truculent in its suppression of decisions and to produce as many of them as it conceivably can, they are dicta and do not insure, such less require, that there will *ever* be meaningful Patent Office compliance with 5 U.S.C. 552(a).

REASONS WHY THE WRIT SHOULD BE GRANTED

1. The question of whether there should be full public access to Patent Office decisions, incluidng those which interpret its rules and the statutes it is charged with administering, looms large in light of the "notorious difference" between patentability standards applied by the courts and those applied by the Patent Office, about which this Court expressed concern in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966) and again in *Kewanee Oil Co.* v. *Bicron Co.*, 416 U.S. 470, 488 (1974). Indeed, as recently as July 29, 1977, the District Court for the District of South Carolina, in *The Duplan Corporation* v. *Deering Milliken Inc., et al*, No. 71-306, blamed this chasm between courts and Patent Office at least in part for the toll, in time and energy, that patent-antitrust litigation is exacting from the federal judiciary, stating:

> "It is not easy to assign definite causes for this proliferation of patent-antitrust litigation in recent years, but at least part of the blame must be laid at the door of the United States Patent Office which, despite protestations to the contrary, seems unable to say 'no' to any patent solicitor who has the persistence to prosecute a patent through as many as six rejections. The result is that many weak patents are being issued which begin their lives with scant hope of survival if subjected to the stern tests of Sections 102 and 103 under current case law." (Slip op. 187-188)

The importance of this question is underscored by this Court's own holding in *National Labor Relations Board* v. *Sears, Roebuck & Co.*, 421 U.S. 132, 153 (1975), that 5 U.S.C. 552(a)(2) "represents a strong congressional aversion to 'secret [agency] law' . . .;[11] and represents an affirmative congressional purpose to require disclosure

[11] Citing Davis, The Information Act: A Preliminary Analysis, 34 U.Chi.L.Rev. 761, 797 (1967).

of documents which have 'the force and effect of law' . . ." [12]

Until it can be known fully both what the secret law of the Patent Office *is*, as set forth in its decisions rendered since 1853, and the reasons for that secret law, any effort to explain the gulf between courts and agency, including the "possible explanation" recognized by this Court in footnote 17 to its *Kewanee* opinion, *supra*, 416 U.S. at 488, is the rankest of speculation. And until the reasons for this gulf are fully explained, efforts to bridge it satisfactorily are necessarily deferred, to the detriment of the whole public whose interest in the patent system has primacy over that of all individuals and small groups.[13]

2. The "congressional aversion to secret [agency] law . . . and . . . purpose to require disclosure" of agency decisional law expressed in *Sears, Roebuck, supra*, are overlaid by congressional recognition, subsequent to adoption of Section 552(a), of the current low degree of public trust and confidence in the executive branch of government.[14]

[12] Citing H.R. Report No. 1497, p. 7.

[13] This Court first emphasized in *Pennock* v. *Dialogue*, 27 U.S. (2 Pet.) 1, 19 (1829) that the Constitution authorizes the patent system for a primary public purpose to which even the inventor's reward is subordinate. To the same effect, see *Deepsouth Packing Co.* v. *Laitram Corp.*, 406 U.S. 518, 530-531 (1972); *Blonder-Tongue Lab., Inc.* v. *University of Ill. Foundation*, 402 U.S. 313, 343-45 (1971); *Lear, Inc.* v. *Adkins*, 395 U.S. 653, 674 (1969); *Mercoid Corp.* v. *Mid-Continent Inv. Co.*, 320 U.S. 661, 665-66 (1944); *United States* v. *Masonite Corp.*, 316 U.S. 265, 278 (1942); *Motion Picture Patents Co.* v. *Universal Film Manufacturing Co.*, 243 U.S 502 (1917); *Kendall* v. *Winsor*, 62 U.S. (21 How.) 322, 329 (1858); *Shaw* v. *Cooper*, 32 U.S. (7 Pet.) 292, 320 (1833).

[14] See, *e.g.*, remarks of Senator Ribicoff made on November 6, 1975 on the Senate floor on the occasion of voting on the "Government in Sunshine Act", 121 Cong. Rec. 19433. The Senator noted, *inter alia*, that "testimony Mr. Harris [the well-known opinion pollster]

It is widely and understandably believed that excessive secrecy at all levels of the executive branch has been utilized expediently—even maliciously—to maintain and enlarge empires, big and small, which the bureaucracy has nurtured.[15] The Patent Office is one of the earliest federal agencies still in existence, having been established under the Patent Act of 1836.[16] It has operated under a enveloping pall of secrecy, breached, if at all, at its own option, for a major portion of the ensuing 140 years.[17]

Its very age suggests strongly not only that the probability of infection of its processes including decision-making functions, with some form of administrative dry rot is high, but that the time is ripe for resolving the question of the extent to which it *is* publicly accountable for its decisions.

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provided the Government Operations Committee last year", showed that "only 36 percent of the people think that 'most public officials are dedicated to helping the country rather than being out for themselves' ".

[15] For a specific recognition of the empire-building tendencies of the Patent Office bureaucracy, see, *e.g.*, the special concurring opinion of Mr. Justice Douglas, joined by Mr. Justice Black, in *Great A & P Tea Co.* v. *Supermarket Equipment Co.*, 340 U.S. 147, 154-158 (1950), which also notes that "the opportunity which discretion affords to expand its own jurisdiction" played a significant role in the Patent Office toleration and implementation of the low patentability standard deplored by this Court in *Graham, supra*, and *Kewanee, supra*.

[16] 7 Stat. 117.

[17] Pointedly, Patent Office decisions such as are here sought have been publicly available as of right since 1853 only to the extent that they appear in files of applications which issued as patents. Public availability of all other Patent Office decisions has been conditioned upon the whim of the Patent Commissioner. The result, manifestly, is that the public has access primarily to those of the Patent Office decisions that the Patent Office *wants* the public to know about, and is precluded from seeing those that may show administrative ineptitude, confusion or even, possibly, venality.

The primary issue on this petition, subsumed in its first three questions—*i.e.*, whether the Patent Office is subject to 5 U.S.C. 552(a)(2)'s mandate—deserves a forthright answer in the interest of the whole public rather than the evasions so far advanced.

3. To the extent that the decisions below condone the Patent Office post-litigation destruction of the best means for locating and identifying the decisions sought—*i.e.*, the docket cards, themselves urged by petitioner to be an index requested by the complaint—they conflict directly with this Court's own decision in *Merrimack River Savings Bank* v. *City of Clay Center*, 219 U.S. 527 (1911) which holds that

> ". . . the willful removal beyond the reach of the court of the subject-matter of the litigation, or its destruction . . . is, in and of itself a contempt of the appellate jurisdiction of this court." 219 U.S. at 535-6.

See also *Clay* v. *Waters*, 178 F. 387, 391 (8 Cir. 1910), holding that

> "A party to a suit, who knowingly and intentionally disposes of its subject-matter with intent to withdraw it from the jurisdiction of the court and to render futile any future decree concerning it, unavoidably defies the power and affronts the dignity of the court and thereby renders himself liable to punishment for contempt. [citing cases]"

This conflict should be resolved now.

4. The decisions below reflect a confusion in both the Court of Appeals and the District Court for the District of Columbia as to the ambit of the indexing requirement of 5 U.S.C. 552(a). Contrary to the limitation of that requirement in *this* case to decisions defined by 5 U.S.C. 552(a)(2)(A) only, *Sears, Roebuck & Co.* v. *National Labor Relations Board*, 346 F.Supp. 751 (D.D.C. 1972),

aff'd 480 F.2d 1195 (D.C. Cir. 1973); aff'd as to that point and rev'd in part in *Sears, Roebuck, supra;* specifically held that indexing requirement to apply to decisions described in 5 U.S.C. 552(a)(2)(C) and *Tax Analysts and Advocates* v. *Internal Revenue Service*, 362 F.Supp. 1298 (D.D.C. 1973) made the same holding as to decisions described in 5 U.S.C. 552(a)(2)(B). This confusion in the courts that determine the bulk of cases arising under 5 U.S.C. 552 should be resolved by this Court.

5. Congress has also expressed increasing concern of late with the need to enhance public confidence in the judicial system. In implementation of that goal, Congress substantially revised 28 U.S.C. 455(a) in 1974 to adopt essentially the "appearance of fairness" test delineated in *United States* v. *Columbia Broadcasting System*, 497 F.2d 107, 110 (5 Cir. 1974).[18]

Questions 4 and 5 are addressed to those aspects of the proceedings below which conflict in principle with the "appearance of fairness" test in that (a) the district court's *ex parte* consultations with the Patent Office prevented the petitioner-plaintiff from being fairly heard in the district court and (b) the court of appeals' refusal to conform the erroneous statements of fact in its opinion to the record necessarily are prejudicial to petitioner in this Court and in any remand proceedings that may ensue.

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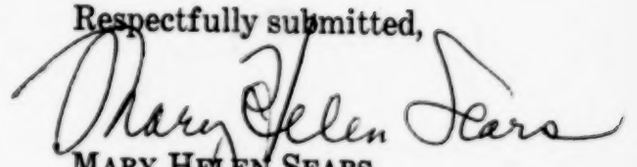
[18] See S.R. 93-419, 93rd Cong., 1st Sess. (1973); H.R. 93-1453, 93rd Cong., 2nd Sess. (1974); Hearings before the Subcommittee on Improvements in Judicial Machinery, Committee on the Judiciary, United States Senate, 93rd Cong., 1st Sess., esp. at 93 and 114 (1973); Note, "Disqualification of Judges and Justices in the Federal Courts", 86 Harvard L. Rev. 736, 745-6 (1973).

CONCLUSION

The writ should be granted as asked.

Respectfully submitted,



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APPENDICES

APPENDIX A

No. 74-1365

EDWARD S. IRONS, APPELLANT

v.

ROBERT GOTTSCHALK, COMMISSIONER OF PATENTS

Appeal from the United States District Court
for the District of Columbia
(D.C. Civil Action 75-70)

Decided October 21, 1976

Before: TOM CLARK,* *Associate Justice* of the Supreme Court of the United States (Ret.), BAZELON, *Chief Judge*, ROBINSON, *Circuit Judge*

Opinion for the Court filed by Mr. Justice Clark.

MR. JUSTICE CLARK: Appellant, Edward S. Irons is here on a return engagement in his six-year effort to secure disclosure of "all the unpublished manuscript decisions of the Patent Office" under the Freedom of Information Act. 15 U.S.C. § 552, *et seq.* It was in 1970 that the District Court refused disclosure on the ground that the request had not been focused on "identifiable records"; however it did direct the Commissioner of Patents to make public the indices of such manuscript decisions that had been made since the effective date of

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* Sitting by designation pursuant to 28 U.S.C. § 294(a).

the Act, July 4, 1967, which significantly commemorated our Independence Day. *Irons* v. *Schuyler*, 321 F. Supp. 628 (1970). On appeal this court upheld the finding that the request was not one for "identifiable records" but remanded for a determination of Iron's request for the indices of decisions made prior to July 4, 1967. *Irons* v. *Schuyler*, 151 U.S. App. D.C. 23 465 F. 2d 608, *cert. denied* 409 U.S. 1076 (1972). On remand, the district court ordered that the indices for 144 volumes of patent materials be furnished; however, the 31 remaining bound folio volumes, covering the years 1923-1954 and not having any indices, were not included in the order; nor were the unbound files for the remaining years to 1967. The district court denied a rash of motions, all the way from one to file an amended complaint[1] to two motions for contempt based on the Commissioner's routine destruction of docket cards and file wrappers and his decision to index only the final opinions of the Patent Office under the court's order to furnish indices on post-1967 manuscript decisions.[2] 396 F. Supp. 403 (1974).

Upon the filing of this Order (January 10, 1974), appellant moved to vacate it, to re-open the proceedings, and to disqualify the district judge on the ground that a member of the court staff had made an informal inspection of the Patent Office warehouse and the materials appellant had requested, unaccompanied by appellant or his counsel. In denying the motion on March 16, 1974, the district court said:

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[1] The district court found the allegations of the proposed amended complaint were either "clearly the same type of broad, sweeping, and indiscriminate request originally denied" or were already before the district court in other motions filed by appellant.

[2] The district court found that the Commissioner was complying with its earlier order by indexing all "final decision" materials; and that the remaining materials requested, such as statements of policy, staff manuals, staff instructions, etc. affecting the public were already being made available.

> The Court, in its effort to reach a just and expeditious conclusion to the matter, made a physical inspection of certain items to assure that the relief granted January 10, 1974, (release of the indices to bound manuscript decisions) was both physically possible and meaningful to plaintiff. The Court finds no element of prejudice to the plaintiff in the action of November 30, 1973 [The date of the visit to the warehouse by a member of the district court's staff].

This appeal covers both the January 10th Order as well as the one dated March 11, 1974, and seeks "vacation of any residue of the decision below and remand for a fair hearing before a different judge."

1. *Issues on this appeal*:

The appellant raises no less than eight issues. He argues that (1) all 175 bound folio volumes of Patent Office decisions covering the years 1853-1954 and the decisions since the enactment of the Freedom of Information Act in 1967 must be made publicly available; (2) all documents capable of being used as indices to locate manuscript decisions, including file wrappers and docket cards must be made publicly available, with exempted information blocked out in lieu of withholding the entire document; (3) the Commissioner of Patents' destruction of docket cards subsequent to the filing of appellant's complaint was contempt of this Court and the district court; (4) this Court's earlier ruling in *Irons* v. *Schuyler*, 465 F. 2d 608 (1972), was in error because the Commissioner's misrepresentations about the identifiability and scope of appellant's request, and if not, then the amendment to 5 U.S.C. § 552 enacted by Congress on November 21, 1974, overruled this Court's decision in *Irons* v. *Schuyler*, *supra*; (5) the district court improperly revised, *sua sponte*, its earlier order, affirmed by this Court, by limiting the post-1967 indices to § 552(a)

(2)(A) material; (6) the Commissioner's failure to index § 552(a)(2)(B) and (C) materials was contempt of the district court; (7) the district judge deprived appellant of due process and a fair hearing by refusing the amended complaint, refusing oral examination of the Commissioner's counsel, denying summary judgment, considering Commissioner's sworn and unsworn testimony after his earlier affidavit was shown to be false in part, and engaging in *ex parte* contact with the Patent Office and subsequently refusing to recuse himself and vacate his orders because of such contact; (8) the decision below is void because of the *ex parte* contact with the Patent Office, the refusal to allow oral examination of the Commissioner's counsel, and the entry of judgment based upon *ex parte* findings and the inadmissible statements of the Commissioner's counsel.

We have carefully canvassed these issues and find only two have merit: (1) Whether the 175 volumes of manuscript decisions are exempt from disclosure under the Freedom of Information Act, 5 U.S.C. § 552 *et seq*; and (2) should the district court have allowed the filing of the amended complaint.

2. *The Scope and Extent of the Patent Exemption, 35 U.S.C. § 122*:

The Freedom of Information Act, 5 U.S.C. § 552 *et seq.*, provides that certain documents and materials are exempt from its mandates. Among these exemptions is the one provided for "records specifically exempted from disclosure by statute," § 552(b)(3).[3] The patent act

[3] We note at this point that the "Government in the Sunshine Act," 5 U.S.C. § 552b, P. L. 94-409, 90 Stat. 1241, was signed into law by the President on September 13, 1976.

Notwithstanding the fact that exemption 3 of the FOIA, 5 U.S.C. § 552(b)(3) was amended to exempt from disclosure matters "specifically exempted from disclosure by statute (other than section 552b of this title), provided that such statute (A) requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) establishes particular criteria for withholding or refers to particular types of matters to be withheld," we are of the opinion that this amendment does not alter the outcome of this opinion.

35 U.S.C. § 122 gives the Commissioner considerable discretion to disclose matters otherwise protected by that section, and, as such, it does not satisfy the requirements of proviso (A) of the new amendment. However, § 122 does "refer to particular types of matters to be withheld," and hence would be within the terms of proviso (B).

We are of the opinion that patent applications will still be entitled to confidentiality despite the more restrictive language of the amendment, and the procedure we set out *infra* will continue to be applicable.

makes specific provision for the confidentiality of patent applications, 35 U.S.C. § 122:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

The district court held that 35 U.S.C. § 122 exempts from disclosure the 175 volumes of manuscript decisions as portions of pending or abandoned application files, but that the indices to those volumes, where available, must be made public in order to assist appellant and others in the drafting of specific requests that may or may not be subject to the exemption. Admittedly, non-exempt materials exist among the volumes' contents. The district court, therefore, refused to authorize examination of the volumes on the basis of appellant's broad request. In view of the fact that the appellant could not formulate a more specific request under the circumstances, a matter to be discussed in some detail *infra*, we respectfully disagree with the conclusions reached by the district court.

At the outset, it is well that we first reiterate this Circuit's prior determination that:

> The District Court did not hold, nor do we, that the manuscript decisions of the Patent Office are exempt, as such, from disclosure.

Irons v. *Schuyler*, 465 F. 2d 608, 614 (D.C. Cir. 1972). The provisions of the patent act itself permit the publication of patents that have been granted and the specifications and drawings of those patents, 35 U.S.C. § 11 (a) (1). We thus reserve for some later determination the question of whether § 122's declaration of confidentiality for patent applications extends to successful applications and manuscript decisions involving the same. On the other hand, the 175 volumes sought by the appellant contain manuscript decisions with "information concerning" pending and abandoned patent applications. The applications themselves are clearly protected by § 122. *Sears* v. *Gottschalk*, 502 F. 2d 122 (4th Cir. 1974).

In *Sears*, counsel for appellant here sought to require disclosure of "all abandoned U.S. patent applications". The request was not significantly different in form from the original request of appellant in this case for "all unpublished manuscript decisions of the Patent Office." The Fourth Circuit examined the legislative history of 35 U.S.C. § 122 and came to the conclusion that abandoned and pending patent applications were not subject to disclosure under the Freedom of Information Act, 5 U.S.C. § 522 *et seq.* because of the 35 U.S.C. § 122 exemption. *Id.* at 130-1.

The instant case, however, presents a somewhat different problem. Appellant seeks disclosure of manuscript decisions made by the Patent Office, some of which will reveal quotations from and detailed knowledge of protected pending or abandoned patent applications, but none of which contain the abandoned or pending patent

applications *in toto* that *Sears* found protected by § 122. Thus, we face the question of whether § 122 *specifically* exempts manuscript decisions of the Patent Office within the scope of 5 U.S.C. § 552 (b) (3), when those manuscript decisions reveal salient portions and detailed knowledge of the confidential abandoned or pending patent applications. In short, we must interpret the "information concerning" clause of Section 122.

The purpose of the Freedom of Information Act was to ensure by statute the Government's broad obligation to provide its citizens access to its information. The Act's language is broad, emphasizing disclosure, and its exemptions are narrow, eschewing exception. The language of Exemption 3 of the Freedom of Information Act, § 552 (b) (3) is precise: it extends only to matter that is "*specifically* exempted from disclosure by statute" (emphasis added). If the language of § 122 specifically exempts manuscript decisions in pending or abandoned patent applications, appellant has no statutory right to demand disclosure; if the language of § 122 does not specifically exempt manuscript decisions in such cases, appellant has a statutory right to disclosure.

Vaughn v. *Rosen* 484 F. 2d 820 (1973) presented many of the same problems to this Circuit in 1973 that the case at hand presents to us today. While *Vaughn* dealt with the Civil Service Commission's refusal to disclose certain personnel records to a professor doing research on the Commission, the arguments and discussion are analogous to those presently before us. We therefore look to *Vaughn* for guidance.

This case does not involve purely protected documents, but rather integrated volumes of both exempt and non-exempt material. A blanket order requiring the release of the volumes to the appellant *in toto* would necessarily result in the disclosure of information covered by the ex-

emption. To refuse appellant's request for the volumes simply because some exempt material is contained therein would deny appellant his right to the non-exempt material. The court does not feel bound to simply choose one of these two extreme alternatives. Rather, we are satisfied that 35 U.S.C. § 122 and 5 U.S.C. § 552 can be reconciled in such a manner that the exempt material remains undisclosed, and that the non-exempt material is disclosed.

Vaughn stated that "an entire document is not exempt merely because an isolated portion need not be disclosed." *Vaughn*, *supra*, p. 825. We believe that this principle applies to the manuscript decisions before us today. Those portions of the decisions which contain protected information can be excised in order that the non-exempt portions can be disclosed. Extending this reasoning to entire volumes, we find that the volumes cannot be denied the appellant *in toto* solely on the ground that the volumes contain exempt information. Again, the exempt portions of the volumes can be removed prior to disclosure to the appellant.

This court is cognizant of the tremendous number of manhours which will be required to remove the privileged information from the volumes requested. However, we are of the opinion that the emphasis on disclosure under the FOIA mandates this action.

We now turn to the specificity of the appellant's request for the purpose of determining its sufficiency. In *Irons* v. *Schuyler*, 465 F. 2d 608 (1972), this court held at p. 612 that the requisite degree of specificity was "a reasonable description enabling the Government employee to locate the requested records." This court is of the opinion that the appellant's amended complaint for 175 volumes was specific enough to meet this standard under the facts of this case. The burden of claiming the § 122

exemption should now shift to the Patent Office. The Office should designate which portions of which documents it deems exempt.

The appellant has made as specific a request as possible for the 175 volumes and the other manuscript decisions. As we understand it, the only means of making a specific request is by the use of indices. While there are no indices available for the bulk of the material requested, those that are available indicate only the case name, number, and date of decision. There is no subject matter index, digest, or synopsis of the decisions currently in use. While it would be tempting to recognize the hardship on the agency in "getting its house in order" and deny the appellant's claim for disclosure for lack of specificity in his request, this would encourage agencies to procrastinate in the formulation of a usable, systematic index or other form or procedure which will allow the framing of precise requests for information.

We note at this point that § 122 concerns "information" and that disclosure of this information may be made on two grounds: (1) if necessary to carry out the provisions of any Act of Congress, or (2) in such special circumstances as may be determined by the Commissioner. While we do not make any finding today on the first of these two grounds, we do think that the second (a determination by the Commissioner) does indicate that, barring any overriding concerns to the contrary, the Commissioner may, of his own accord, release any information requested without having to wage a courtroom battle under the Freedom of Information Act.

Finally, we turn to the question of which manuscript decisions constitute "final opinions" for purposes of § 552(a)(2)(A). Unfortunately, this court lacks a sufficiently detailed and focused record to make such a determination. Therefore, we are unable to reach this issue.

However, a procedure for compiling an adequate record is set out in our old friend *Vaughn*. "Respect for the enormous document-gathering capacity of government agencies compels us to recognize that the raw material of an FOIA lawsuit may still be extremely burdensome to a trial court. In such cases, it is within the discretion of a trial court to designate a special master to examine documents and evaluate an agency's contention of exemption. This special master would not act as an advocate; he would, however, assist the adversary process by assuming much of the burden of examining and evaluating voluminous documents that currently falls on the trial judge." *Vaughn, supra*, p. 828. If determining which of the manuscripts are "final opinions" does present too time-consuming a task to the trial court, as it well might, the use of a special master for the above-stated purpose should certainly be considered. Additionally, the special master might make determinations as to whether certain portions of manuscript decisions are exempt or non-exempt.

In summary, our findings are as follows: (1) the appellant's amended complaint was specific enough to place the burden of claiming specific exemptions for specific parts of the manuscript decisions and the volumes on the agency; (2) 35 U.S.C. § 122 does not exempt either the requested manuscript decisions or the requested volumes *in toto*, but rather exempts only portions of the requested material containing detailed information and salient knowledge pertaining to the patent applications; (3) determination as to which documents constitute "final opinions" was impossible due to our lack of an adequate record.

It is our opinion that this case should be remanded to the district court for determining which materials are exempt and which are non-exempt, and with directions to the Patent Office to excise those portions of the

requested documents which would reveal confidential information, and other proceedings not inconsistent with this opinion.

As a final note, we look to one further observation in *Vaughn*. "The procedural requirements we have spelled out herein may impose a substantial burden on an agency seeking to avoid disclosure. Yet the current approach places the burden on the party seeking disclosure, in clear contravention of the statutory mandate. Our decision here may sharply stimulate what must be, in the final analysis, the simplest and most effective solution—for agencies voluntarily to disclose as much information as possible and to create internal procedures that will assure that disclosable information can be easily separated from that which is exempt. A sincere policy of maximum disclosure would truncate many of the disputes that are considered by this court. And if the remaining burden is mostly thrust on the Government, administrative ingenuity will be devoted to lightening the load." *Vaughn, supra*, p. 828.

APPENDIX B

MEMORANDUM-ORDER OF THE DISTRICT COURT ENTERED JANUARY 10, 1974

This matter came before the Court upon remand from the Court of Appeals to consider plaintiff's request for indices of manuscript decisions and to further examine matters relating to the original complaint.[1]

Originally, this Court entered an Order on October 26, 1970, granting defendant's motion to dismiss the complaint,[2] except insofar as this Court ordered the Patent Office to create and maintain an index of current unpublished manuscript decisions.[3] Plaintiff had requested "all unpublished manuscript decisions together with such indices as are available." This Court rejected that request as too broad to be "identifiable records" within the meaning of 5 U.S.C. § 552(a)(3), and, accordingly, denied the request. Because it appeared that plaintiff would be unable to formulate a request of the necessary specificity without some sort of index being available, the Order required the Patent Office to create and maintain a current index under 5 U.S.C. § 552(a)(2).

On appeal, plaintiff renewed his claim as to both the manuscript decisions and the indices. The Court of Ap-

[1] "Construing the request for indices as separate from the request for all manuscript decisions, we think appellant is entitled to a remand for consideration and disposition of this part of the case . . . . We of course leave open the question whether the remand . . . might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion . . . ."

465 F.2d 608, 613-14 (D.C. Cir. 1972).

[2] 321 F. Supp. 628 (D.D.C. 1970).

[3] *Id.* at 629.

peals affirmed the dismissal of the complaint as to the request for all manuscript decisions,[4] but left open for reconsideration on remand the question of available indices and also the possibility that an amended complaint could be framed to make the records request acceptable.[5]

The Court held an oral hearing May 10, 1973, and received detailed memoranda from each side exploring the question of the available indices. In addition, plaintiff has sought to file an amended and a second amended complaint, and numerous other motions have been made.

I. The Indices.

The indices plaintiff seeks fall into three categories. The first involves a series of bound volumes collecting manuscript decisions from 1853 to 1954. There are 175 volumes in the series, in which manuscript decisions are chronologically arranged.[6] Bound into the front of volumes 1 through 144 is an alphabetical index consisting of 26 pages, one page for each letter of the alphabet.[7] On each page is listed the name in which the patent application was filed, and the page number at which the decision in that application appears. Because the volumes are of folio size and each consists of three to four hundred pages, and because most manuscript decisions are one page or less, each volume contains a large number of decisions.

If these indices were to be made available, the Patent Office would have to copy them via a photographic repro-

[4] 465 F.2d 608, 613, 614 (D.C. Cir. 1972).

[5] *Id.* at 613-15.

[6] Affidavit of Raymond E. Martin, Associate Solicitor of the United States Patent Office at 2 (June 2, 1970).

[7] Information for this further description is based upon inspection of the Patent Office records warehouse November 30, 1973, by this Court's staff.

duction method. It is estimated that two man-days and an expenditure of $300 would be required to reproduce the approximately 3,744 pages in question.

The Court feels that these indices should be made available. Without the aid of some sort of index, plaintiff will forever be unable to formulate with specificity a request for manuscript decisions that would permit the Patent Office to produce the material desired. The current index being maintained by the Patent Office pursuant to the Court's Order of October 26, 1970, includes only decisions from July 4, 1967, forward.[8] This Court is clearly without authority to order the creation of an index for any material prior to that date,[9] but it is possible to order the reproduction of existing indices insofar as they are "identifiable records" that may be requested under 5 U.S.C. § 552(a)(3).

The Patent Office has raised some objections to the reproduction and release of these indices. In short, it contends that 35 U.S.C. § 122 (confidential status of patent applications) requires the Patent Office to refrain from giving out any information about patent applications. Because abandoned applications are considered to be covered by this section,[10] the Patent Office argues that to release an index to manuscript decisions bound in a volume containing decisions in both abandoned as well as granted patent applications is to violate 35 U.S.C. § 122, because giving out the name of the applicant (as listed in the index) is giving out "information." The Court finds this argument of insufficient merit to prevent the release of the indices.

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[8] 321 F. Supp. at 629.

[9] The Freedom of Information Act only provides for a current index. 5 U.S.C. § 552(a)(2). *See* Davis, Administrative Law Treatise, § 3A.14 (1970 Supp.).

[10] *See* United States Department of Commerce, Patent Office, Rules of Practice 14(b) (January 1970).

35 U.S.C. § 122 states:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

The Freedom of Information Act was designed to "establish a general philosophy of full agency disclosure unless information is exempted under clearly delineated statutory language . . . ."[11] The statutory language of 35 U.S.C. § 122 does not clearly delineate what "no information" means. It strains reason, however, to say the release of the name of an applicant is conclusively barred when Section 122 also states that "information" may be released if "necessary to carry out the provisions of any Act of Congress. . . ." 5 U.S.C. § 552 is such an Act.

Case law has recognized that Section 122 does not throw an impenetrable cloak of secrecy around all aspects of patent applications. Although in the context of patent interference litigation rather than a Freedom of Information Act case, courts have uniformly held that disclosure of confidential files must be made where justice requires.[12] Because Section 122 cannot be grounds for maintaining secrecy when it would be unreasonable to have such

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[11] S. Rep. No. 813, 89th Cong., 1st Sess. 3 (1965). "A democratic society requires an informed, intelligent electorate, and the intelligence of the electorate varies as the quantity and quality of its information varies." H. Rep. No. 1497, 89th Cong., 2d Sess. 12 (1966).

[12] *See, e.g., James B. Clow & Sons, Inc.* v. *United States Pipe and Foundry Co.*, 313 F.2d 46, 51 (5th Cir. 1963); *Struthers Scientific & Int'l Corp.* v. *General Foods Corp.*, 45 F.R.D. 375, 381 (S.D. Texas 1968); *Britt Tech. Corp.* v. *L. & A. Products, Inc.*, 223 F. Supp. 126 (D. Minn. 1963); *Cardex Corp.* v. *Olin Mathieson Chemical Corp.*, 23 F.R.D. 27, 31 (S.D. Ill. 1958); *Great Lakes Carbon Corp.* v. *Continental Oil Co.*, 23 F.R.D. 33 (W.D. La. 1958).

secrecy, it cannot bar the revelation of applicants' names in the indices in question.[13] Further, the most recent of the manuscript decisions involved in 1923. The intervening fifty years reduces significantly the possibility that any prejudice could result from the revelation of an applicant's name in this index.

The Patent Office further argues that the recent decision by Judge Oren Lewis in *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973, supports its position that the indices cannot be released under 35 U.S.C. § 122. The demand made in that case was for "all existing abandoned United States patent applications." [14] Judge Lewis held that abandoned applications, maintained in secrecy pursuant to Section 122 and Patent Office rules,[15] are exempted under 5 U.S.C. § 552(b)(3), the prior statute exemption.[16] This Court is in agreement with Judge Lewis' ruling, but feels it does not support the Patent Office's position insofar as these indices are concerned. There is a vast difference between a broad, sweeping request for the entire contents of all abandoned patent applications and the release of a 70-year compilation of indices containing only the bare name of the applicant.

II. Further indices.

Plaintiff claims that further indices exist and should be released. The claimed indices are "docket cards" and

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[13] Of course, the Patent Office may at its option review these indices with an eye toward blocking out the names of any and all applicants who have not been granted a patent. The Court recognizes, however, that a tremendous number of man-hours would be required to perform this task, and does not feel that such editing is necessary to comply with Section 122.

[14] *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. V. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973.

[15] See note 10, *supra*, and accompanying text.

[16] *Sears* v. *Gottschalk*, *supra*, at 1329-30.

"file wrapper jackets." The former is a master card for recording each and every event in the course of processing a patent application; the latter serves a similar function, but is at the same time attached to the front of the applications file. Neither the cards nor the jackets are collected in any way that would serve a regular index function within the Patent Office, and they contain considerably more information about individual applications than do the indices discussed in Part I.

This sort of material is not a true index, and cannot be considered as such for the use of plaintiff. Further, because each contains considerably more information about the application, including an indication of the type of invention involved, these items fall into the group of materials protected by 35 U.S.C. § 122 and the rulings of *Misgades & Douglas* v. *Schuyler*, 328 F. Supp. 619 (E.D. Va. 1971), and *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973). Accordingly, docket cards and file wrapper jackets will not be made available to plaintiff as an index.

III. Amended Complaint.

Plaintiff has submitted motions for leave to file an amended, and later, a second amended complaint. That latter proposed complaint evidently represents a further adjustment of the complaint to conform with the facts of the case and with the spirit of the Court of Appeals' recommendation that further consideration in this Court may lead to "the possibility of such amendment of the complaint as the District Court may permit in the exercise of a sound discretion . . . ." 465 F.2d 608, 614 (D.C. Cir. 1972).

Where a motion to dismiss the complaint has been granted and sustained, as is the case here, the trial court has discretion to permit amendment of the complaint only where the order of the Court of Appeals specifically

provides for such action.[17] Because that is the case here, this Court must consider whether or not the amended complaint will cure the defects of the original one.[18] In this case, it must be said that it will not. Additional relief is already being granted to the extent that certain existing indices will be made available. As to the remainder of additional relief demanded by plaintiff, the Court, in the exercise of its discretion, denies leave to file either the amended or second amended complaint. Even so, virtually every form of relief requested by plaintiff in the second amended complaint is before the Court in the form of separate motions. For instance, on June 19, 1973, plaintiff moved for partial summary judgment under Fed. R. Civ. P. 56 and 54(c), seeking an order requiring the Patent Office to produce (1) the "170 to 175 volumes" of manuscript decisions covering the years 1853-1954, and (2) any and all indices that may exist in the files of the Patent Office, including the indices to the bound volumes, the individual docket cards, and the file wrapper jacket. The only additional items sought by the proposed second amended complaint are (1) all manuscript decisions from 1955 to the present and any unbound decisions prior to 1955, (2) an order forbidding the Patent Office from continuing its periodic destruction of old abandoned patent applications, and (3) an order requiring the Patent Office to comply fully with this Court's Order of October 26, 1970.

The first of these three issues, the demand for all manuscript decisions not included in the 175 bound volumes, is clearly the same type of broad, sweeping and indiscriminate request originally denied by this Court October 26, 1970, and sustained by the Court of Appeals June 15, 1972. No such amendment will be allowed.

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[17] *Ginsberg* v. *Stern*, 242 F.2d 379 (3rd Cir. 1957); *United States* v. *Newberry Mfg. Co.*, 123 F.2d 453 (1st Cir. 1941).

[18] See Kirsch v. Barnes, 157 F. Supp. 671 (N.D. Cal. 1957).

The second and third of these three issues raised in the proposed second amended complaint that are not found in the motion for partial summary judgment are before this Court by way of separate motions submitted by the plaintiff. Specifically, on June 11, 1973, plaintiff moved for a "rule to show cause why defendant should not be held in contempt for willful obstruction of justice," referring to the destruction of certain docket cards. Because docket cards have already been considered and rejected as an "available index" pursuant to the remand from the Court of Appeals,[19] this motion will be denied, and the Patent Office may continue routine destruction of agency records.[20] Also, on June 11, plaintiff moved this Court for a "rule to show cause pursuant to 5 U.S.C. § 552(a)(3) and Fed. R. Civ. P. 70 why defendant should not be held in contempt for failure to comply with October 26, 1970 Order." This motion will be considered below.[21]

Thus it is apparent that despite denying leave to file an amended complaint, the Court is giving consideration to every issue reasonably raised therein through consideration of the two motions of June 11, 1973, and the motion for partial summary judgment of June 19, 1973.

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[19] *See* Part II.

[20] The proposed second amended complaint also complains of the destruction of manuscript decisions. It is evidently the policy of the Patent Office to consider abandoned applications eligible for destruction after twenty years, and presumably manuscript decisions contained therein would also be destroyed. *See* United States Department of Commerce, Patent Office, Rules of Practice 14(b) (January 1970). Because plaintiff's broad request for all manuscript decisions was denied by the Court, affirmed on appeal, it would not be appropriate to consider such routine agency destruction of old manuscript decisions. However, any manuscript decisions contained in the bound volumes 1-144 to which an index will be made available, and any manuscript decisions indexed under this Court's Order of October 26, 1970, may not be destroyed.

[21] See Part V, *infra*.

IV. Summary Judgment.

As previously noted, on June 19, 1973, plaintiff moved the Court for partial summary judgment, seeking the 175 bound volumes of manuscript decisions compiled from 1853 to 1954, and any and all indices to manuscript decisions. The latter portion of the request has already been dealt with extensively pursuant to the Court of Appeals' remand and will not be repeated here.[22]

Asking for 175 bound folio volumes of manuscript decisions does somewhat narrow plaintiff's original request, but still lacks requisite specificity. Each volume contains hundreds of decisions, thus making the compilation one of about 100,000 decisions. The question of whether or not this is a request for "identifiable records" within the meaning of *Bristol-Myers Co.* v. *F.T.C.*, 424 F.2d 935 (D.C. Cir. 1970), and *American Mail Line, Ltd.* v. *Gulick*, 411 F.2d 696 (D.C. Cir. 1969), need not be decided here, however, for another consideration takes precedence. Because a manuscript decision in a patent application is protected as being a portion of that file,[23] release of the bound volume *in toto* would mean release of manuscript decisions in pending and abandoned applications as well as granted ones—and the former have a confidential status that is protected by Section 122.[24]

By ordering the release of the indices to all those volumes which are presently indexed, i.e., volumes 1-144, the Court is making available to plaintiff a means for formulating a more specific request. If a requested manu-

[22] See Parts I and II, *supra*.

[23] *Cf. Misegades & Douglas* v. *Schuyler*, 328 F. Supp. 619 (E.D. Va. 1971), *appeal dismissed* 456 F.2d 255 (4th Cir. 1972).

[24] The Court recognizes that very few of the manuscript decisions in question would be in still-pending applications, but is also mindful that abandoned applications have been held to enjoy that same secrecy. *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973.

script decision is available to the public, the Patent Office will be able to produce the volume containing that decision and thereby make the decision available.[25] If a requested decision is not available because the application was never granted, the Patent Office will so inform the one making the request. In this way plaintiff and all others will be assured a means of access to all those bound decisions from 1853 to 1923 which can be made available under Section 122. Accordingly, that portion of plaintiff's motion for summary judgment which requests all 175 bound volumes will be denied.

V. Contempt Motion

Plaintiff moves to hold defendant in contempt of Court for failure to fully comply with the October 26, 1970, Order requiring that

> the United States Patent Office maintain and make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967, insofar as the same is required by 5 U.S.C. § 552(a)(2).

321 F. Supp. at 629.

Plaintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions, but rather raises questions as to material referred to in

[25] The Patent Office has objected to this procedure on the grounds that if it must produce a volume containing a requested decision, the person requesting the decision would then be able to see decisions in that same volume held in confidentiality under Section 122. The Court feels that by either reproducing and making available a copy of the requested decision or by monitoring the requester as he reads and/or copies the requested decision, any such feared breach of confidentiality can easily be avoided. There is little likelihood that the volume of requests would be such as to seriously inconvenience the Patent Office.

5 U.S.C. § 552(a)(2)(B) and (C), that is, statements of policy not published in the Federal Register, staff manuals and instructions to staff affecting the public. The Court notes that these items were never requested in plaintiff's original complaint, and as a result, they were not incorporated into the Order of October 26, 1970. Because that Order has been affirmed and this case is on remand for limited purposes only, the issue of whether or not the Patent Office is fully indexing Section 552 (a)(2)(B) and (C) material is not properly before the Court.

Upon inspection of the indices being maintained, the Court finds full compliance with the October 1970 Order. The Patent Office has compiled five indices which comprehensively cover Board of Appeals decisions, Board of Patent Interference decisions, and Commissioner's decisions. For the first group, two indices are maintained: one consists of decisions in granted applications, i.e., those generally available to the public. This index lists the patent application number, and classifies the decisions into 36 categories, with cross-references to other applicable categories. Determining the nature of the categories is a simple exercise. The second Board of Appeals index is one compiling all other decisions under coded appeals numbers, and thus indexes both unavailable decisions (pending, denied or abandoned applications) and very recently available decisions (those which have matured into patents after the entry of the decisions indexed and before the next updating of the "public" index). This latter index is also available to the public, and upon request the Patent Office will research the file of a particular application to see whether or not it can be publicly released. The two indices are both updated quarterly.

Board of Patent Interference decisions are treated in two indices, in a like fashion to Board of Appeals decisions, but one not updated on a regular basis.[26] These indices of decisions are also classified in 36 categories, but are not cross-referenced in the manner of the Board of Appeals decisions. Both are available to the public on the same terms as the Board of Appeals indices.

Commissioner's decisions have been one index, covering both available and protected decisions, compiled by a system of code numbers. Due to their particular scope and function,[27] very few of these decisions would ever be available to the public. Therefore, when a request for one is made, the Patent Office will research its files to see if release would be permissible. The Court has also gone on to investigate 5 U.S.C. § 552(a)(2)(B) and (C) material, and found that there are apparently no statements of policy, staff manuals or staff instructions that are not already available to the public. Accordingly, the Court overrules this motion.

VI. Conclusion

The Court has carefully considered all matters brought to its attention by both the remand from the Court of Appeals and the various motions and memoranda filed by the parties, and accordingly, it is by the Court this 10th day of January, 1974,

ORDERED that each index bound in the front of volumes 1-144 be reproduced and made available in order to aid plaintiff in formulating more specific requests for identifiable records under 5 U.S.C. § 552(a)(3); and it is further

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[26] There are many fewer such decisions, and quarterly up-dating is highly wasteful in terms of computer operation time; accordingly, the Patent Office has no regular schedule for up-dating these indices, but anticipates roughly annual review.

[27] United States Department of Commerce, Patent Office, Rules of Practice 113 and 181 (January 1970).

ORDERED that plaintiff's motion for partial summary judgment be granted only insofar as the indices of bound volumes 1-144 are concerned; and it is further

ORDERED that the remaining portions of plaintiff's motion for partial summary judgment be denied; and it is further

ORDERED that plaintiff's motion for leave to file a second amended complaint be denied; and it is further

ORDERED that plaintiff's contempt motion as regards routine destruction of agency records be denied; and it is further

ORDERED that plaintiff's contempt motion for failure to comply with this Court's Order of October 26, 1970, be denied; and it is further

ORDERED that plaintiff's motion to reconsider granting defendants' motion to quash subpoena on Raymond Martin (Order of May 7, 1973) be denied as moot.

/s/ Oliver Gasch, Judge

APPENDIX C

MEMORANDUM-ORDER OF THE DISTRICT COURT

ENTERED MARCH 11, 1974

This matter comes before the Court upon plaintiff's motion to vacate the Court's Memorandum-Order of January 10, 1974, to recuse the district judge and to reopen proceedings. Only the second of these points, the requested recusal, necessitates consideration.

This action was filed under the Freedom of Information Act against the Commissioner of Patents in 1970, seeking access to all past manuscript decisions of the Patent Office. On October 26, 1970, this Court granted defendant's motion to dismiss for lack of a sufficiently specific request, except insofar as the defendant was ordered to maintain a current index of manuscript decisions to aid plaintiff in formulating more specific requests. Plaintiff appealed. The United States Court of Appeals sustained the dismissal, but remanded for exploration of existing indices that would aid plaintiff in stating a request; the Court of Appeals also indicated that such exploration "might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion . . . . 151 U.S.App.D.C. 23, 29, 465 F.2d 608, 614.

After a hearing and after consideration of lengthy memoranda submitted by both parties, this Court issued the Memorandum-Order in question, which denied leave for plaintiff to file his second amended complaint on the grounds that the proposed complaint was still lacking in the necessary specificity under 5 U.S.C. § 552 (a)(3). However, the Court dealt with virtually every

issue raised in the proposed complaint through consideration of several additional motions filed by plaintiff. Some further relief was granted, that is, the release of certain existing indices which may aid plaintiff in formulating requests of the necessary specificity.

In considering the many questions raised by plaintiff upon remand, the Court deemed it advisable to gain a better perspective on the materials actually in issue. To this end, a member of this Court's staff viewed the Patent Office warehouse November 30, 1973, to see exactly what bound volumes of manuscript decisions were in existence and to examine the indices attached thereto. At the same time, the Court also sought to ascertain the nature of the indices being maintained by the Patent Office under the Memorandum-Order of October 26, 1970. This effort by the Court to more accurately ascertain what lay at the root of this action was not hidden from the plaintiff, as it was fully acknowledged in the Memorandum-Order of January 10, 1974, footnote 7.

The conduct of the Court in all litigation should be focused on securing "the just, speedy, and inexpensive determination of every action." Fed. R. Civ. P. 1. It was to this end that a physical inspection of the manuscript decisions and indices was made. An *in camera* inspection would have required the transfer of numerous bulky and heavy items to the Court House, clearly a burden on both the Patent Office and this Court. The method chosen was to send a member of this Court's staff to the Patent Office to report on the physical existence and makeup of these items. Both judicial economy and economy of the parties was served.

Plaintiff has made many varied allegations in support of the motion for recusal. First, plaintiff assumes that at least two separate visits were made; in fact, the only visit was that of November 30, 1973, fully identified by the Court in the Memorandum-Order. Further, plaintiff objects to the characterization of the bound volumes inspected as being a "compilation . . . of about 100,000 decisions" as not having previously appeared in the record. It is a simple exercise to note the average length of manuscript decisions and the number of pages in an average volume in order to reach the conclusion that 175 volumes contain approximately that number of decisions. Plaintiff himself indicated in open Court that the number of unpublished manuscript decisions is "[m]any thousands I am quite sure." The Court can see no prejudice in this finding.

Plaintiff objects to the Court's characterization that "[i]t is estimated that two man-days and an expenditure of $300 would be required to reproduce the approximately 3,744 pages in question." It is difficult to understand plaintiff's objection to this finding, inasmuch as the Court ordered those indices reproduced. Nor does it indicate a damaging *ex parte* presentation of the Patent Office, as it is a simple exercise for anyone vaguely familiar with photocopy techniques to make a rough estimate of the time and expense involved in the reproduction of 3,744 folio pages.

Plaintiff has also pointed to the Court's staff inspection of the indices being maintained by the Patent Office pursuant to the Memorandum-Order of October 26, 1970, as further evidence of *ex parte* conduct. It should be noted that in the Order of January 10, 1974, the Court found that "[p]laintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions . . . ," and that the contempt motion under consideration was "not properly before the Court." However, because this litigation has centered around the need for indices from which plaintiff and other members of the public could make a request of the necessary specificity of the Patent Office, the Court deemed it wise to inspect the indices, which are available to the public,

to ascertain whether there has been full compliance with this Court's Order of October 26, 1970. This inspection, like that of the records warehouse, was a physical identification of material.

Plaintiff also would appear to be accusing the United States Attorney of filing a false sworn answer to his interrogatory no. 14. That highly unusual interrogatory read:

> Has defendant or any one acting on defendants' behalf, including a member of the U.S. Attorney's staff, been in contact with anyone from Judge Gasch's office or staff, including Judge Gasch, in regard to any aspect of this case, including the timing of future proceedings herein at any time since May 10, 1973?
>
> If the answer to this interrogatory is anything other than an unqualified no, (a) Describe fully each contact including without limitation as a part of the answer the names and addresses of all persons involved, the date, time and circumstances of the meeting including how it came about, the substance of what was said by each involved person and an identification of any and all pertinent documents that may exist.

Michael J. Ryan, Assistant United States Attorney, answered November 15, 1973:

> Interrogatory 14 is highly objectionable as being irrelevant, improper and scandalous, in that it impugns the integrity of both the Court and counsel. The answer, however, is an unequivocal no.

Plaintiff accuses the United States Attorney of a false answer by assuming that an inspection by the Court's staff November 30, 1973, meant that there must have been some contact prior to November 15, 1973. In fact, plaintiff's assumption is wrong, and the answer of

the United States Attorney was not, as plaintiff claims, a false one.

Plaintiff objects to this Court's characterization of docket cards and file wrapper jackets as not being meaningful indices, claiming that no support for the Court's finding is in the record. That is not the case. Information supporting this finding can be found in defendant's Memorandum After Oral Hearing on Plaintiff's Motion for Leave to File Amended Complaint at 3-13.

Plaintiff relies on the case *In Re Murchison*, 349 U.S. 133 (1955), wherein the Supreme Court found that a judge who had conducted a secret "one man grand jury" in a contempt proceeding could not preside at the ensuing trial of the same matter. The Court's action in making a staff inspection of the manuscript decisions and the indices being maintained pursuant to this Court's prior Order is vastly different. This litigation has been long and difficult. Many motions have been considered, it has been heard by the Court of Appeals and again by this Court on remand. An extensive record exists. The Court, in its effort to reach a just and expeditious conclusion to the matter, made a physical inspection of certain items to assure that the relief granted January 10, 1974, (release of the indices to bound manuscript decisions) was both physically possible and meaningful to plaintiff. The Court finds no element of prejudice to the plaintiff in the action of November 30, 1973.

Accordingly, it is by the Court this 11th day of March, 1974,

ORDERED that plaintiff's motion to vacate the Memorandum-Order of January 10, 1974, to recuse and to reopen proceedings be and the same is hereby denied.

/s/ Oliver Gasch
Judge

APPENDIX D

MARCH 8, 1977

ORDER OF THE COURT OF APPEALS

BEFORE: TOM CLARK,* Associate Justice of the Supreme Court of the United States (Ret.), BAZELON, Chief Judge; and ROBINSON, Circuit Judge

ORDER

IT IS ORDERED by the Court, *sua sponte*, that the opinion for the Court filed herein on October 21, 1976 be, and hereby is, amended to add a footnote at the end of the second complete paragraph of Page 9 of the slip opinion to follow the words ". . . it deems exempt." which footnote shall be designated footnote number 4 and it shall read as follows:

> 'On the record before us, we cannot say whether appellant's request for the *unbound* decisions for the period from 1954 to 1967 is sufficiently specific to enable the government to locate these documents with reasonable effort. *See* National Cable Television v. FCC, 479 F.2d 183, 190-193 (D.C. Cir. 1973). If the government believes that this portion of appellant's request lacks this requisite degree of specificity, then on remand it may introduce evidence to that effect in the district court. In the absence of such a showing, however, we believe that the government must bear the burden of claiming specific exemptions for specific parts of the unbound, as well as the bound, manuscript decisions.

Per Curiam
FOR THE COURT:

/s/ George A. Fisher
GEORGE A. FISHER
Clerk

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* Sitting by designation pursuant to 28 U.S.C. § 294(a).

APPENDIX E

MOTION OF APPELLANT UNDER APPELLATE RULE 27 FOR CORRECTION OF FACTUAL ERRORS IN OPINION FILED OCTOBER 21, 1976

Plaintiff hereby moves the Court, pursuant to Rule 21, to correct the following fact errors in its opinion, filed October 21, 1976:

1. At p. 3, lines 1-2, one of appellant's motions for contempt is described as "based on the Commissioner's routine destruction of docket cards and file wrappers".

(a) The words "and file wrappers" should be deleted. This motion (App. 146) and its supporting memorandum (App. 147-149) show clearly that destruction of "file wrappers" was **not** raised. Defendand's opposition (App. 168-169) likewise does not refer to file wrappers.

(b) The word "routine" should be deleted. The record contains *no evidence* of any nature that there *was* an established routine. There are no published rules or publicly available procedure manuals or other staff instructions that refer in any way to a "routine" or established prccedure for docket card index destruction. Appellee's own *ipse dixit* on which appellant was denied opportunity for discovery *or* cross-examination is that after this suit was already pending, there having been *no* prior destruction whatever, appellee *commenced* separate destruction, on a one time basis, of cards for abandoned applications (App. 108) and cards for allowed applications. (App. 109).

2. The opinion at p. 3 alleges that "appellant moved to vacate . . ., to reopen the proceedings and to disqualify the district judge on the ground that a member of the court staff had made an informal inspection of the Patent

Office warehouse and the materials appellant had requested, unaccompanied by appellant or his counsel".

The motion was *not* on the ground of "informal inspection", but on the ground of *ex parte*, undisclosed, communications and conferences between the judge's staff and appellee's advocate regarding controverted matters, upon the basis of which the district court made fact findings and conclusions that have *no* record support. See App. 195-206; App. 212-217. The identified statement should be corrected to reflect the true facts.

3. The Court's footnote 2, p. 3, fails to note that the district court finding therein described has *no* record support and was made on the basis of the *still undisclosed* discussions between Judge Gasch's staff and the appellee's advocates that occurred on the date of the alleged "inspection" at the Patent Office warehouse in Suitland, Maryland, and at the Patent Office *per se* in Arlington, Virginia. Appellant was given no opportunity to demonstrate, *as he could if permitted to do so*, that the finding is **false** in asserting "that the remaining materials requested . . . were already being made available". The footnote should be corrected to show the finding lacks record support.

4. At p. 4, numbered item 5 refers to the district court's "earlier order" directing the Patent Office to index post-July 4, 1967 indices as required in 5 U.S.C. 552(a) as "affirmed by this Court". That order was *not* so "affirmed" because *it was never before this Court for appellate decision.* To the contrary, appellee withdrew its initial notice of appeal from the district court's October 25, 1970 decision **before** docketing thereof and this Court never considered the indexing aspect of that order. The words "affirmed by this Court" should be deleted as inaccurate.

5. The statement that "We thus reserve for some later determination the question of whether § 122's declaration

of confidentiality for patent applications extends to successful applications and manuscript decisions involving the same" (p. 6) should be wholly deleted. There is **no** issue on this point. The Patent Office routinely grants public access on request to the entire files of all issued patents, *including* all unpublished decisions therein. Access to the bound volumes containing the same decisions would facilitate their use by lawyers and other interested members of the public and is understood to be contemplated by this Court's October 21, 1976 opinion. Whether those decisions *can* be made available is not a subject of controversy, however—and the Court's opinion should be amended as suggested to avoid confusing the point.

6. There was *no question* posed to this Court on this appeal of what constituted "final opinions" under § 552 (a) (2) (A). All suggestions to the contrary at pp. 10-11 of the opinion should be excised therefrom.

In addition, appellant's amended complaint (App. 7-11) which the opinion holds that the district court should proceed upon is expressly *not* limited to 5 U.S.C. 552(a) (2) (A), but instead is expressly inclusive of decisions defined in 5 U.S.C. 552(a) (2) (B); hence any implication that further proceedings may turn upon an undefined "finality" question is simply incorrect and should be disavowed.

CONCLUSION

This motion should be granted.

Respectfully submitted,

/s/ Mary Helen Sears
MARY HELEN SEARS
Attorney for Appellant

APPENDIX F

BEFORE: Tom Clark,* Associate Justice of the Supreme Court of the United States (Ret.); Bazelon, Chief Judge; Robinson, Circuit Judge

ORDER

Upon consideration of the motion of appellant Irons for correction of alleged factual errors in the opinion of this Court filed and entered on the docket concurrently with a judgment remanding this case to the District Court, it is

ORDERED by the Court that appellant's motion is denied.

Per Curiam

For the Court:

GEORGE A. FISHER
Clerk

* Sitting by designation pursuant to 28 U.S.C. § 294(a).

APPENDIX G

5 U.S.C. 552

§ 552. Public information; agency rules, opinions, orders, records, and proceedings

(a) Each agency shall make available to the public information as follows:

(1) Each agency shall separately state and currently publish in the Federal Register for the guidance of the public—

(A) descriptions of its central and field organization and the established places at which, the employees (and in the case of a uniformed service, the members) from whom, and the methods whereby, the public may obtain information, make submittals or requests, or obtain decisions;

(B) statements of the general course and method by which its functions are channeled and determined, including the nature and requirements of all formal and informal procedures available;

(C) rules of procedure, descriptions of forms available or the places at which forms may be obtained, and instructions as to the scope and contents of all papers, reports, or examinations;

(D) substantive rules of general applicability adopted as authorized by law, and statements of general policy or interpretations of general applicability formulated and adopted by the agency; and

(E) each amendment, revision, or repeal of the foregoing.

Except to the extent that a person has actual and timely notice of the terms thereof, a person may not in any man-

ner be required to resort to, or be adversely affected by, a matter required to be published in the Federal Register and not so published. For the purpose of this paragraph, matter reasonably available to the class of persons affected thereby is deemed published in the Federal Register when incorporated by reference therein with the approval of the Director of the Federal Register.

(2) Each agency, in accordance with published rules, shall make available for public inspection and copying—

(A) final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases;

(B) those statements of policy and interpretations which have been adopted by the agency and are not published in the Federal Register; and

(C) administrative staff manuals and instructions to staff that affect a member of the public;

unless the materials are promptly published and copies offered for sale. To the extent required to prevent a clearly unwarranted invasion of personal privacy, an agency may delete identifying details when it makes available or publishes an opinion, statement of policy, interpretation, or staff manual or instruction. However, in each case the justification for the deletion shall be explained fully in writing. Each agency shall also maintain and make available for public inspection and copying current indexes providing identifying information for the public as to any matter issued, adopted, or promulgated after July 4, 1967, and required by this paragraph to be made available or published. Each agency shall promptly publish, quarterly or more frequently, and distribute (by sale or otherwise) copies of each index or supplements thereto unless it determines by order published in the Federal Register that the publication would be unnecessary and

impracticable, in which case the agency shall nonetheless provide copies of such index on request at a cost not to exceed the direct cost of duplication. A final order, opinion, statement of policy, interpretation, or staff manual or instruction that affects a member of the public may be relied on, used, or cited as precedent by an agency against a party other than an agency only if—

(i) it has been indexed and either made available or published as provided by this paragraph; or

(ii) the party has actual and timely notice of the terms thereof.

(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, upon any request for records which (A) reasonably describes such records and (B) is made in accordance with published rules stating the time, place, fees (if any), and procedures to be followed, shall make the records promptly available to any person.

(4) (A) In order to carry out the provisions of this section, each agency shall promulgate regulations, pursuant to notice and receipt of public comment, specifying a uniform schedule of fees applicable to all constituent units of such agency. Such fees shall be limited to reasonable standard charges for document search and duplication and provide for recovery of only the direct costs of such search and duplication. Documents shall be furnished without charge or at a reduced charge where the agency determines that waiver or reduction of the fee is in the public interest because furnishing the information can be considered as primarily benefiting the general public.

(B) On complaint, the district court of the United States in the district in which the complainant resides, or has his principal place of business, or in which the agency records are situated, or in the District of Columbia, has

jurisdiction to enjoin the agency from withholding agency records and to order the production of any agency records improperly withheld from the complainant. In such a case the court shall determine the matter de novo, and may examine the contents of such agency records in camera to determine whether such records or any part thereof shall be withheld under any of the exemptions set forth in subsection (b) of this section, and the burden is on the agency to sustain its action.

(C) Notwithstanding any other provision of law, the defendant shall serve an answer or otherwise plead to any complaint made under this subsection within thirty days after service upon the defendant of the pleading in which such complaint is made, unless the court otherwise directs for good cause shown.

(D) Except as to cases the court considers of greater importance, proceedings before the district court, as authorized by this subsection, and appeals therefrom, take precedence on the docket over all cases and shall be assigned for hearing and trial or for argument at the earliest practicable date and expedited in every way.

(E) The court may assess against the United States reasonable attorney fees and other litigation costs reasonably incurred in any case under this section in which the complainant has substantially prevailed.

(F) Whenever the court orders the production of any agency records improperly withheld from the complainant and assesses against the United States reasonable attorney fees and other litigation costs, and the court additionally issues a written finding that the circumstances surrounding the withholding raise questions whether agency personnel acted arbitrarily or capriciously with respect to the withholding, the Civil Service Commission shall promptly initiate a proceeding to determine whether disciplinary action is warranted against the officer or employee who

was primarily responsible for the withholding. The Commission, after investigation and consideration of the evidence submitted, shall submit its findings and recommendations to the administrative authority of the agency concerned and shall send copies of the findings and recommendations to the officer or employee or his representative. The administrative authority shall take the corrective action that the Commission recommends.

(G) In the event of noncompliance with the order of the court, the district court may punish for contempt the responsible employee, and in the case of a uniformed service, the responsible member.

(5) Each agency having more than one member shall maintain and make available for public inspection a record of the final votes of each member in every agency proceeding.

(6)(A) Each agency, upon any request for records made under paragraph (1), (2), or (3) of this subsection, shall—

(i) determine within ten days (excepting Saturdays, Sundays, and legal public holidays) after the receipt of any such request whether to comply with such request and shall immediately notify the person making such request of such determination and the reasons therefor, and of the right of such person to appeal to the head of the agency any adverse determination; and

(ii) make a determination with respect to any appeal within twenty days (excepting Saturdays, Sundays, and legal public holidays) after the receipt of such appeal. If on appeal the denial of the request for records is in whole or in part upheld, the agency shall notify the person making such request of the provisions for judicial review of that determination under paragraph (4) of this subsection.

(B) In unusual circumstances as specified in this subparagraph, the time limits prescribed in either clause (i) or clause (ii) of subparagraph (A) may be extended by written notice to the person making such request setting forth the reasons for such extension and the date on which a determination is expected to be dispatched. No such notice shall specify a date that would result in an extension for more than ten working days. As used in this subparagraph, "unusual circumstances" means, but only to the extent reasonably necessary to the proper processing of the particular request—

(i) the need to search for and collect the requested records from field facilities or other establishments that are separate from the office processing the request;

(ii) the need to search for, collect, and appropriately examine a voluminous amount of separate and distinct records which are demanded in a single request; or

(iii) the need for consultation, which shall be conducted with all practicable speed, with another agency having a substantial interest in the determination of the request or among two or more components of the agency having substantial subject-matter interest therein.

(C) Any person making a request to any agency for records under paragraph (1), (2), or (3) of this subsection shall be deemed to have exhausted his administrative remedies with respect to such request if the agency fails to comply with the applicable time limit provisions of this paragraph. If the Government can show exceptional circumstances exist and that the agency is exercising due diligence in responding to the request, the court may retain jurisdiction and allow the agency additional time to complete its review of the records. Upon any determination by an agency to comply with a request for records, the records shall be made promptly available to such person making such request. Any notification of denial of any request for records under this subsection shall set forth the names and titles or positions of each person responsible for the denial of such request.

(b) This section does not apply to matters that are—

(1) (A) specifically authorized under criteria established by an Executive order to be kept secret in the interest of national defense or foreign policy and (B) are in fact properly classified pursuant to such Executive order;

(2) related solely to the internal personnel rules and practices of an agency;

(3) specifically exempted from disclosure by statute (other than section 552b of this title), provided that such statute (A) requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) establishes particular criteria for withholding or refers to particular types of matters to be withheld;

(4) trade secrets and commercial or financial information obtained from a person and privileged or confidential;

(5) inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency;

(6) personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy;

(7) investigatory records compiled for law enforcement purposes, but only to the extent that the production of such records would (A) interfere with

enforcement proceedings, (B) deprive a person of a right to a fair trial or an impartial adjudication, (C) constitute an unwarranted invasion of personal privacy, (D) disclose the identity of a confidential source and, in the case of a record compiled by a criminal law enforcement authority in the course of a criminal investigation, or by an agency conducting a lawful national security intelligence investigation, confidential information furnished only by the confidential source, (E) disclose investigative techniques and procedures, or (F) endanger the life or physical safety of law enforcement personnel;

(8) contained in or related to examination, operating, or condition reports prepared by, on behalf of, or for the use of an agency responsible for the regulation or supervision of financial institutions; or

(9) geological and geophysical information and data, including maps, concerning wells.

Any reasonably segregable portion of a record shall be provided to any person requesting such record after deletion of the portions which are exempt under this subsection.

(c) This section does not authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section. This section is not authority to withhold information from Congress.

(d) On or before March 1 of each calendar year, each agency shall submit a report covering the preceding calendar year to the Speaker of the House of Representatives and President of the Senate for referral to the appropriate committees of the Congress. The report shall include—

(1) the number of determinations made by such agency not to comply with requests for records made

to such agency under subsection (a) and the reasons for each such determination;

(2) the number of appeals made by persons under subsection (a)(6), the result of such appeals, and the reason for the action upon each appeal that results in a denial of information;

(3) the names and titles or positions of each person responsible for the denial of records requested under this section, and the number of instances of participation for each;

(4) the results of each proceeding conducted pursuant to subsection (a)(4)(F), including a report of the disciplinary action taken against the officer or employee who was primarily responsible for improperly withholding records or an explanation of why disciplinary action was not taken;

(5) a copy of every rule made by such agency regarding this section;

(6) a copy of the fee schedule and the total amount of fees collected by the agency for making records available under this section; and

(7) such other information as indicates efforts to administer fully this section.

The Attorney General shall submit an annual report on or before March 1 of each calendar year which shall include for the prior calendar year a listing of the number of cases arising under this section, the exemption involved in each case, the disposition of such case, and the cost, fees, and penalties assessed under subsections (a)(4)(E), (F), and (G). Such report shall also include a description of the efforts undertaken by the Department of Justice to encourage agency compliance with this section.

(e) For purposes of this section, the term "agency" as defined in section 551(1) of this title includes any executive department, military department, Government corporation, Government controlled corporation, or other establishment in the executive branch of the Government (including the Executive Office of the President), or any independent regulatory agency.

As amended Pub.L. 93-502, §§ 1-3, Nov. 21, 1974, 88 Stat. 1561-1564; Pub.L. 94-409, § 5(b), Sept. 13, 1976, 90 Stat. 1247.

Supreme Court, U. S.
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No. 77-203

In the Supreme Court of the United States

OCTOBER TERM, 1977

EDWARD S. IRONS, PETITIONER

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

WADE H. MCCREE, JR.,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

In the Supreme Court of the United States

OCTOBER TERM, 1977

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LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS

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MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Petitioner brought this action pursuant to the Freedom of Information Act, 5 U.S.C. 552, to compel disclosure of " 'all unpublished decisions of the Patent Office' and existing indices thereto" (Pet. 6).[1] The district court awarded

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[1]This case has been before the court of appeals three times, and before this Court twice. In 1972, this Court denied petitioner's petition for certiorari, 409 U.S. 1076, from the court of appeals' initial decision in this case, 465 F. 2d 608 (C.A. D.C.), which affirmed the district court's dismissal of the complaint insofar as it requested all unpublished manuscript decisions, but remanded for further consideration regarding the request for indices. In 1974, petitioner sought summary reversal of a decision of the district court on the ground that the district judge had engaged in improper *ex parte* contact with representatives of the respondent. The court of appeals denied petitioner's motion for summary reversal, and this Court denied certiorari. 420 U.S. 946.

disclosure only of certain indices (Pet. App. B). The court of appeals, in a decision that was substantially favorable to petitioner, reversed in part and remanded (Pet. App. A). The court agreed with petitioner that his request for disclosure (as amended during the litigation) was sufficiently specific to shift to the agency the burden of claiming an exemption from the Act, and it rejected the government's claim that 35 U.S.C. (Supp. V) 122 (which requires applications for patents to be kept confidential), and Exemption 3 of the Act, 5 U.S.C. 552(b)(3), exempt unpublished decisions *in toto*. However, the court concluded that those provisions do exempt the portions of such decisions that contain "detailed information" and "salient knowledge" pertaining to patent applications (Pet. App. A, p. 10a), and it concluded that the record was not adequate to permit it to determine which documents constituted "final opinions" subject to disclosure. Accordingly, the court remanded the case "to the district court for determining which materials are exempt and which are non-exempt, and with directions to the Patent Office to excise those portions of the requested documents which would reveal confidential information * * *" (Pet. App. A, pp. 10a-11a).

Petitioner challenges this decision on several grounds, none of which has merit or warrants further judicial consideration.

1. Petitioner contends (Pet. 2) that the Freedom of Information Act entirely overrides the requirement in 35 U.S.C. (Supp. V) 122 that patent applications "be kept in confidence."[2] But the court of appeals correctly held that

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[2]35 U.S.C. (Supp. V) 122 provides:

> Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

35 U.S.C. (Supp. V) 122, which by its plain terms preserves the confidentiality of Patent Office documents insofar as they contain "information concerning" patent applications, is a statute that specifically exempts certain matters from disclosure within the meaning of Exemption 3 of the Freedom of Information Act, 5 U.S.C. 552(b)(3).[3] This decision is consistent with that of the only other circuit to consider this question,[4] and it does not warrant review by this Court.

2. Petitioner also contends (Pet. 17) that the Patent Office improperly destroyed docket cards that would have aided in locating the decisions requested by petitioner. The district court found that the docket cards, which record the events in the course of processing a patent application, are not collected "in any way that would serve a regular index function within the Patent Office" and do not constitute a "true index" (Pet. App. B, pp. 16a-17a). Since the docket cards were not within the scope of petitioner's request for "indices" of decisions, the court

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[3]As the court of appeals correctly observed (Pet. App. A, p. 4a n. 3), disclosure remains barred by Exemption 3 as recently amended, by Pub. L. 94-409, 90 Stat. 1247, since the exemption as amended still applies, *inter alia*, to statutes that refer "to particular types of matters to be withheld." 5 U.S.C. 552(b)(3)(B). 35 U.S.C. (Supp. V) 122 does refer to "particular types of matters"—patent applications and "information concerning the same."

[4]In *Sears* v. *Gottschalk*, 502 F. 2d 122, certiorari denied, 425 U.S. 904, the Fourth Circuit held that 35 U.S.C. (Supp. V) 122 is an "Exemption 3 statute" that exempts abandoned patent applications from disclosure.

of appeals correctly rejected (Pet. App. A, pp. 3a-4a) petitioner's contention that the destruction of the cards constituted contempt of court.

3. Petitioner contends (Pet. 17-18) that the Patent Office must index not only post-1967 "final decisions" but also non-final agency decisions containing policy statements or interpretations. But the district court did not hold that the indexing requirement was inapplicable to statements of policy, staff manuals, or other materials. Instead, the court simply noted that because the issue of indexing such materials had not been raised before the earlier appeal and remand, it was not properly before the court (Pet. App. B, p. 22a). The court indicated, however, that after investigation it had found that there were no such materials not already available to the public (Pet. App. B, p. 23a). Petitioner has not shown this determination to be clearly erroneous, and his contention that the decisions below stand for the proposition that policy statements, staff manuals, and other like materials are not subject to an indexing requirement under the Act is insubstantial.

4. Petitioner reiterates (Pet. 3, 10-13, 18) the argument he made when this case previously was before this Court (see note 1, *supra*), *i.e.*, that review is required here because the trial judge sent his law clerk to the Patent Office during the course of this litigation to make a "physical inspection of certain items" (Pet. App. C, p. 29a). Although petitioner objects to the district court's characterization of the law clerk's visit as a "physical inspection" and instead calls it "*ex parte* consultations" (Pet 18), he has not demonstrated any way in which he was prejudiced by the law clerk's action. The district court expressly concluded that petitioner suffered no prejudice as a result of the physical inspection of the Patent Office (Pet. App. C, p. 29a), and the court of appeals correctly affirmed (Pet. App. A, p. 4a).

5. Finally, petitioner objects to the court of appeals' refusal to correct alleged "factual errors" in its opinion in this case. However, a review of petitioner's motion to correct factual errors (Pet. App. E, pp. 31a-33a) indicates that the "errors" alleged either were so immaterial as not to warrant correction,[5] or were merely arguments and inferences made by the court of appeals with which petitioner does not agree.[6]

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.,
Solicitor General.

NOVEMBER 1977.

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[5]For example, petitioner contended (Pet. App. E, p. 31a) that the court of appeals erred in describing his contempt motions as grounded on a claim that both the docket cards and the file wrapper jackets had been destroyed, since he had not raised any issue regarding file wrappers.

[6]Petitioner objected (Pet. App. E, p. 31a) to the court of appeals' description of the Patent Office's destruction of old docket cards as "routine," and to its description of his motion to vacate as grounded on the district court's "informal inspection" at the Patent Office, rather than on "ex parte * * * communications" (Pet. App. E, p. 32a).

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EDWARD S. IRONS,

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v.

COMMISSIONER OF PATENTS,

Respondent.

PETITIONER'S REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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IN THE

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OCTOBER TERM, 1977

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PETITIONER'S REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The opposition to the present petition is deceptive in its effort to paint an untrue picture of the issues presented. Pointedly,

> (1) It is *not* correct that "Petitioner contends (Pet. 2) that the Freedom of Information Act overrides the requirement in 35 U.S.C. (Supp. V) 122 that patent applications 'be kept in confidence'" (Opp. 2). This is a clear distortion of both 35 U.S.C. 122 *and* petitioner's "contention".
>
> Petitioner contends, *rather*, that 35 U.S.C. 122 itself *requires* that any and all "information concerning" applications for patents be made publicly avail-

able when "necessary to carry out the provisions of any Act of Congress".[1]

Since the Freedom of Information Act (FOIA) *is* an "Act of Congress" *prima facie* requiring public availability of *all* materials covered by 5 U.S.C. 552 (a) (2) (A), (B) and (C), the alternative secrecy provision of 35 U.S.C. 122, applying where *no* "Act of Congress" intervenes, is irrelevant. *This* issue has been raised *only* in the courts below.[2] It is of overriding interest to the proper administration of the patent system and should be determined in this Court *now*, because of its importance and because it was wrongly decided below.

2. Respondent's suggestion that the district court's tainted finding—based on suspect *ex parte* representations of the Patent Office on which the same court refused to permit petitioner to cross-examine or to obtain discovery needed for rebuttal—that docket cards are not used as an index *by the Patent Office*,

[1] 35 U.S.C. 122 provides:

"Confidential status of applications

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. (Amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)"

This statute has been in effect since 1952 and was amended in 1975 only to change "Patent Office" to "Patent and Trademark Office" to reflect a change in name.

[2] Respondent is *wrong* insofar as its cleverly worded note 4 (Opp. 3) suggests *this* question was ever posed or decided in *Sears* v. *Gottschalk*, 502 F.2d 122 (4 Cir. 1975). *In fact*, the issue posed there had nothing to do with any part of 5 U.S.C. 552 (a)(2) or availability of the *decisions* defined therein, but related *only* to availability of abandoned patent application files under 5 U.S.C. 552(a)(*3*).

is irrelevant. Moreover, it is *not true* that the docket cards were "not within the scope of petitioner's request for indices of decisions" (Opp. 3). The district judge himself held that a docket card "is a master card regarding each and every event in the course of processing a patent application" (Pet. 17a)—hence, such a card necessarily affords a way to pinpoint and locate particular events in the processing, such as decisions covered by 5 U.S.C. 552(a) (2). An "index" within the meaning of 5 U.S.C. 552(a) (2) is *anything* that will aid in locating the records in issue.[3] Petitioner indisputably requested access to *all* indices, including the docket cards. What really happened below is that to avoid holding the Patent Office in contempt, both inferior courts resorted to the intellectual dishonesty that what plainly *is* an index in its substance, form and style, is not to be called an index because the Patent Office expediently does not itself make "index" use of the material.

3. The district court *did* hold that insofar as any of the *decisions in issue* may be "statements of policy and interpretations" within 5 U.S.C. 552(a) (2) (B) or "instructions to staff that affect a member of the public" within 5 U.S.C. 552(a) (2) (C) they need not be produced. It did so *without* receiving any evidence as to their nature *on the record* and based solely on its law clerk's surreptitious *ex parte* consultation with the Patent Office, wherein *decisions* were treated entirely separately[4] from 5 U.S.C. 552(a) (2) (B)

[3] See *Wellford* v. *Hardin*, 315 F.Supp. 768 (D.D.C. 1970); Davies, "The Information Act: A Preliminary Analysis", 34 U. Chicago L. Rev. 761, 782-3 (1967). The latter states that an "index" under the FOIA is "any classification system that helps find a paper in a mass of files."

[4] The district court's opinion devotes the bulk of two pages (Pet. 22a-23a) to "decisions" and then states "The Court has *also* gone on to investigate 5 U.S.C. § 552(a)(2)(B) and (C) material, and

and (C) materials. This treatment was expedient and in the teeth of petitioner's *properly raised*[5] Rule 70 motion based on the failure of the Patent Office to obey the district court's 1970 order to index all decisions within 5 U.S.C. 552(a)(2), *Irons* v. *Schuyler*, 321 F.Supp. 628 (D.D.C. 1970). Moreover, the district court arrived at these conclusions *ex parte* without affording (and indeed while affirmatively precluding) opportunity for cross-examination or rebuttal based solely on respondent's self-serving, off-the-record representations first made known to petitioner, as a *fait accompli*, in the district court's decision (Pet. 12a-24a). Such a course of action is not countenanced by law—and respondent's effort (Opp. 4) to play on the *labels* "policy statements, staff manuals . . ." in lieu of addressing the problem, which is the lower courts' holding that Patent Office *decisions* are different from and *do not constitute* "policy statements . . .", as defined in 5 U.S.C. 552 (a)(2)(B) and (C) is, to say the least, unworthy.

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found that there are no statements of policy, staff manuals or staff instructions that are not only available to the public" (Pet. 23a; emphasis added). But the motion related *only to decisions* containing or amounting to "statements of policy and interpretation" and "staff instructions", *not* to *other materials* collected by the agency under the stated labels. By thus focussing on something other than decisions, the district court found an excuse to allow respondent's deliberate disobedience of the 1970 order to pass by.

[5] The failure to comply with the unappealed and hence final 1970 decree was properly raised at *any* time under F.R. Civ. P. 70. The effort to associate this matter with the "earlier appeal and remand" (Opp. 4) and to denominate it "not properly before the court" is inconsistent with the record facts.

The court of appeals, moreover, compounded *this* district court error by incorrectly asserting that the order in question which was *never* appealed was "affirmed by this court [of appeals]" (Pet. 3a). Petitioner's request for correction of the latter *material* error (Pet. 32) in the appellate decision was then summarily, and erroneously, denied.

4. The assertion that "petitioner suffered no prejudice" (Pet. 4) as a result of the *off-the-record*, surreptitious and clandestine November 30, 1973 meetings between the district judge's law clerk and the respondent's representatives is ludicrous on the face of the record. Petitioner has consistently asserted and still maintains that, given the right to cross-examine and rebut the representations made at those meetings, it *could* show gross factual errors in the district court findings. Moreover, the district court ruled *against* petitioner on alleged "facts" the latter was never permitted to meet or rebut, adduced *ex parte* between respondent and the district court. If that is *not* "prejudice", what is?[6]

5. Careful examination of the factual errors in the appellate opinion shows them to be clearly material. In particular, the *prima facie* false assertion first made by the district court that a *one-time only* destruction of docket cards was "routine" is obviously a calculated effort to make the respondent's *deliberate destruction* of an important object of petitioner's FOIA request appear harmless and constitutes a *serious* error of fact in the court of appeals' opinion, contrary to Opp. 5, n. 6. See Pet. 31a, pt. 1(b).

Similarly, the appellate court's *misstatement* of petitioner's ground for its motion to vacate below—see numbered point 2 at Pet. 31a-32a—is not a matter of argument but in the teeth of what the *motion says*. Moreover, the court of appeals *a fortiori* lacked jurisdiction to draw "inferences" (Opp. 5) contrary to the face of the petitioner's motion and appears to have done so in a misguided, improper effort to whitewash the irregularities of the district court proceeding.

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[6] The district court's self-serving "no prejudice" (Opp. 4) ruling is manifestly baseless, as is its erroneous affirmance below.

The other fact errors of the appellate opinion (Pet. 32a-33a; pts. 3-6) will obviously prejudice petitioner on remand, *are material* and *should* have been corrected.

Respectfully submitted,

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